

No. 9327

United States  
Circuit Court of Appeals  
For the Ninth Circuit 4

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PAYNE FURNACE & SUPPLY COMPANY, INC.,  
a corporation,

*Appellant,*

vs.

WILLIAMS-WALLACE COMPANY, a corporation,

*Appellee.*

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**BRIEF FOR APPELLEE**

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A. DONHAM OWEN,

950 Russ Building

San Francisco, California

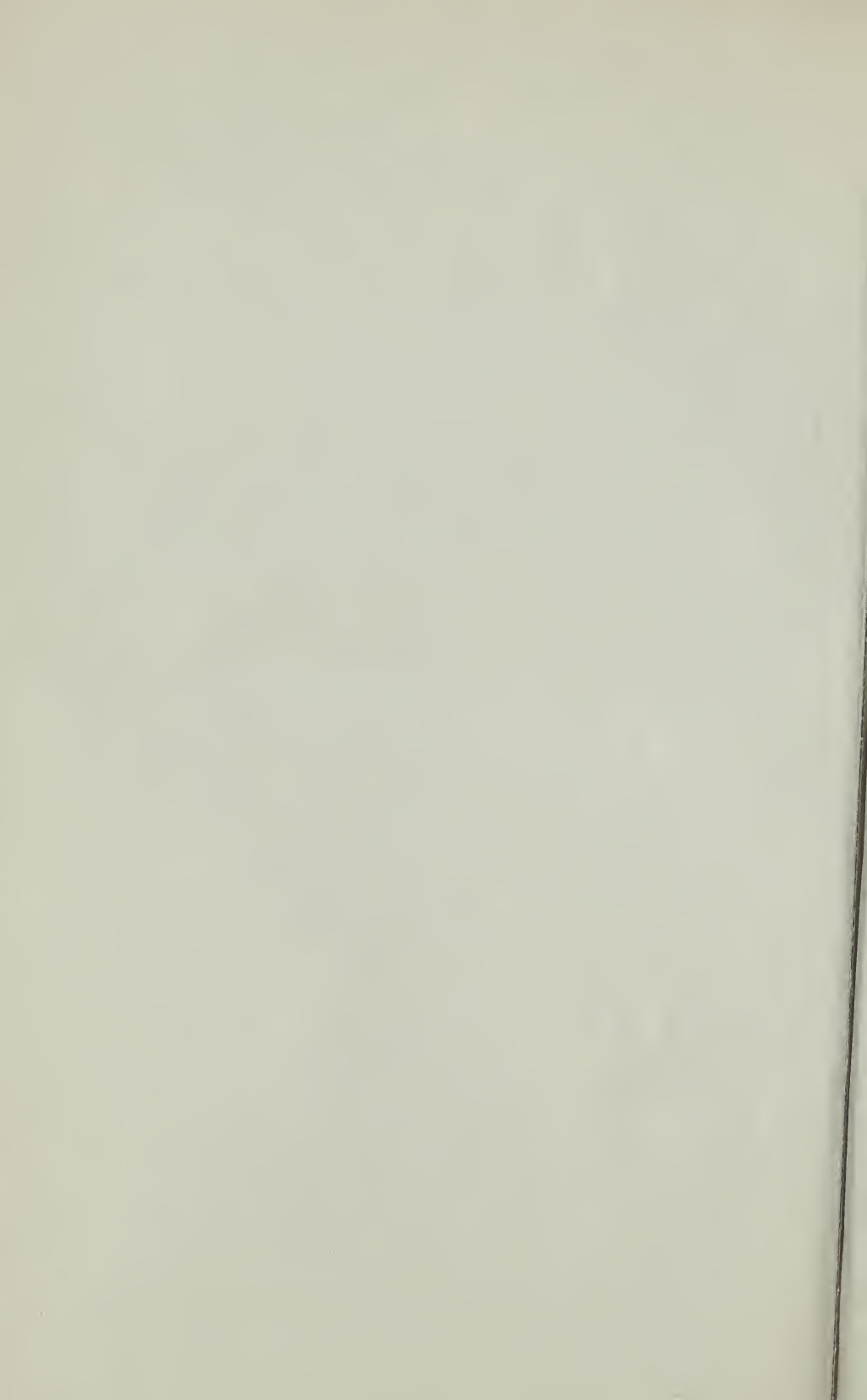
*Attorney for Appellee.*

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PAUL P. O'BRIEN,  
CLERK



# Topical Index

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	Page
STATEMENT OF THE CASE .....	1
Introduction .....	1
The two technical defenses summarized .....	6
TRIAL COURT'S FINDINGS.....	7
THE PATENTED INVENTION .....	10
Illustrative chart of invention.....	Inside back cover
a. The flue pipe problem .....	13
b. The problem is solved by Stadtfeld's invention .....	15
c. Radical novelty of Stadtfeld's invention is apparent..	15
d. Appellant's advertising stresses novelty of the in- vention .....	47
e. The disclaimers .....	18
f. Analysis of structural limitations of disclaimer .....	20
SUMMARY OF ARGUMENT.....	24
ARGUMENT.....	25
1. A patentee is entitled to use the disclaimer statute to limit the claims and elements in the claims "to a spe- cific type of the general class" as the Court below correctly found .....	25
a. The Minerals Separation disclaimer.....	26
b. The United Chromium disclaimer.....	27
c. The Seiberling disclaimer.....	27
2. The Stadtfeld disclaimer did not add an element to the claims therefore it is for the same combination and the Court below correctly found this to be the fact .....	28
a. The Altoona disclaimer.....	29
b. The Fruehauf disclaimer .....	30

	Page
c. The Lowell v. Triplett disclaimer.....	32
d. The Torchio disclaimer.....	33
e. Stadtfeld disclaimer was modelled on Court-ap- proved type .....	35
3. The disclaimer did not make the claims coextensive with any rejected claims or amount to reclaiming re- jected subject matter and the Court below correctly found this to be the fact .....	36
4. The disclaimer did not change the claims to cover a plurality of sections of pipe and the Court below correctly found this to be the fact.....	39
5. A proper limiting disclaimer does not require re-ex- amination of the claims, and is not an evasion of the Reissue Statute .....	39
6. Filing a limiting disclaimer is not an admission that the original claims were invalid .....	41
7. There was no unreasonable delay in filing the dis- claimer as the Court correctly found.....	42
8. The patented invention was novel and it is not dis- closed in the prior art, as the trial court correctly found .....	44
a. Appellant's advertising stresses novelty.....	47
b. The Savage Patent.....	55
c. The abandoned Los Angeles Flue.....	56
Illustrative chart .....	facing page 56
d. The non-analogous paper art.....	60
Two patents show steam pipe covering materials	
Hammill No. 311,750.....	i
Aldrich No. 340,691.....	i
One patent shows a thimble	
Meade No. 1,428,294.....	iii

Page

One patent shows an underground conduit Harvey No. 534,473.....	iv
One patent shows a water pipe Welch No. 1,927,105.....	v
Four patents show hot air pipe O'Toole No. 878,014 .....	v
Bradbeer No. 390,438.....	vii
Line No. 690,744.....	vii
Line No. 696,059.....	vii
9. The Stadtfeld original claims 1, 2 and 3 and cancelled claims 3, 4, 5 and 8 are not prior art and cannot be used to anticipate the patent.....	63
10. The claims are for a patentable combination and not an aggregation, as the trial court correctly found.....	67
CONCLUSION .....	70

## Index of Cases

---

	Pages
Altoona Pub. Theatres v. Am. Tri-Ergon Corp., 294 U. S. 477, 490 (Footnote 3).....	26, 28, 36, 40, 67
Atlantic Refining Company v. James B. Berry Sons' Inc., 40 U. S. P. Q. 2, 6 (C. C. A. 3). (Decided Dec. 21, 1938)	52
Babcock & Wilcox Co. v. Springfield Boiler Co., 16 F. (2d) 964, 969 (C. C. A. 2).....	59
Bay State v. Klein, 20 F. (2d) 915, 917.....	66
Carnegie v. Cambria, 185 U. S. 403, 436.....	23
Carson v. American Smelting & Refining Co., 4 F. (2d) 463, 469, 470 (C. C. A. 9).....	23
Diamond Rubber Co. v. Consolidated Tire Company, 220 U. S. 428, 441.....	7
Dunbar v. Myers, 94 U. S. 187, 193, 194.....	23
Fruehauf Trailer case, 67 F. (2d) 558 (C. C. A. 6).....	30
Hallock v. Davison, 107 Fed. 482, 486.....	70
Hartford-Empire Co. v. Hazel-Atlas Glass Co., 59 F. (2d) 399, 413 .....	53
Hiler Audio Corp. v. General Radio Co., 26 F. (2d) 475, 478 (Mass.) .....	49
Jewell Filter Co. v. Jackson, 140 Fed. 340, 344 (C. C. A. 8)	23
Johnson v. Forty-Second Street, M. & St. N. Ave. R. Co., 33 F. 499, 501.....	47
Johnson v. Philad, 96 F. (2d) 442, 444 (C. C. A. 9).....	37, 38, 64
Judelson v. Hill, 18 F. (2d) 594, affirmed 22 F. (2d) 262 (C. C. A. 2).....	62
Los Alamitos v. Carroll, 173 Fed. 280, 284 (C. C. A. 9).....	58
Lowell v. Tripplett, 17 Fed. Supp. 996 (D. C. Md.).....	31, 40
Mallinekrodt Chemical Works v. E. R. Squibb & Son, 6 F. Sup. 173, 175 (Mo.).....	50
Manhattan v. Helios, 135 F. 785.....	65
Metropolitan v. Cleveland, 36 Fed. (2d) 477 (C. C. A. 6) .....	33, 36, 43

	Pages
Miller v. Bridgeport Brass case, 104 U. S. 350, 352.....	38, 64
Minerals Separation v. Butte & S. Min. Co., 250 U. S. 336, 354, 63 L. Ed. 1019, 1027, 38 S. Ct. 496.....	26, 36
Minerals Separation, Ltd. v. The British Ore Concentration Syndicate, Ltd., et al., 27 R. P. C. 53.....	46
Mohr v. Alliance, 14 F. (2d) 799, 800 (C. C. A. 9).....	52, 59, 63, 69
National Fruit v. Musselman, 8 Fed. Supp. 994, 995 (Pa.).....	66
Nelson v. Meyers, 29 F. (2d) 968, 969 (C. C. A. 6).....	28, 36, 40
Nelson v. Meyers, 56 F. (2d) 512, 513 (C. C. A. 6).....	36, 42
Parks v. Booth, 102 U. S. 96, 104.....	53
Permutit v. Wadham, 13 F. (2d) 454 (C. C. A. 6).....	19, 36, 41, 43
Railroad Supply Co. v. Hart Steel Co., 222 Fed. 261, 273, 274 (C. C. A. 7).....	52
Ray v. Bunting, 4 F. (2d) 214 (C. C. A. 9).....	63
Reinharts, Inc. v. Caterpillar Tractor Co., 85 F. (2d) 628, 635 (C. C. A. 9).....	63
Sachs v. Hartford, 47 F. (2d) 743, 746, 747 (C. C. A. 2)..... .....	15, 21, 23, 36, 68
Sandy MacGregor Co. v. Vaco Grip Co., 2 F. (2d) 655, 656 (C. C. A. 6).....	15
Seiberling v. John E. Thropp's Sons Co., 284 F. 746, 756, 757 (C. C. A. 3).....	27, 36
Stebler v. Riverside, 205 Fed. 735, 738 (C. C. A. 9).....	52, 59, 61, 63
United Chromium v. International Silver Co., 60 F. (2d) 913, 914 (C. C. A. 2).....	27, 36, 65, 66
U. S. Code Title 35, Secs. 65, 71.....	18
Van Meter v. Irving Air Chute Co., 27 F. (2d) 170, 172 (N. Y.) .....	36
Walker on Patents (Deller 6 Ed.) p. 147.....	63
Walker on Patents (Deller 6 Ed.) p. 216.....	68
Wilson v. Union Tool case, 249 F. 729, 735 (C. C. A. 9).....	38





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**BRIEF FOR APPELLEE**

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**STATEMENT**

This is an appeal from a decree entered by Judge Louderback in the Northern District of California, sustaining the validity of Letters Patent No. 2,013,193, owned by appellee, holding it infringed by appellant, and holding that appellant had neither a shopright, an implied license nor an express license under the patent (I. 62).<sup>\*</sup> Infringement was admitted, as appellant's construction is a

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<sup>\*</sup>For uniformity, the Roman numeral refers to the volume of the Record and is followed by the page number.

NOTE: Emphasis in quotations ours, unless otherwise noted.

“Chinese copy” of the patent (I. 82). Appellant has abandoned the alleged license or shopright defense. This reduces the questions before this Court to an examination of the findings of the District Court on validity of the patent. The jurisdiction of the Court below and of this Court is unquestioned.

The patent (III. 637) was issued to cover an important new development made in flue pipes by Jacob A. Stadtfeld. The patented device has turned out to be of very real importance in its field and is one of only two metal flue pipes (both invented by Stadtfeld) which are approved for installation by city and county building authorities (II. 554). It is being marketed on a nationwide scale and is steadily displacing other kinds of flue pipe. For some time prior to the patented invention there was no approved metal flue pipe. Those that had been used earlier had failed and were forbidden by law (II. 372). The problem had been acute for a number of years (II. 574). Stadtfeld’s search for a successful flue pipe began about 1920 (II. 501) and continued practically constantly up to the date of his discovery in the fall of 1932 of the invention covered by the patent in suit (Fdg. 24). Others, including appellant, were also searching to discover the correct construction of a flue pipe for venting gas burning appliances but none succeeded. There was a long felt want (II. 574). Nothing in the prior art was either acceptable to the authorities or efficient as a flue pipe. Appellant’s have not been able to change from the patented construction to any of the prior art constructions.

Stadtfeld’s experience was that of the typical inventor, —a poor man who had spent all he could get together to

carry on further experiments. Then when the goal was achieved he was penniless and at the mercy of anyone who wanted to take unfair advantage of him. Appellant attempted this but, fortunately, without success.

Stadtfeld's first attempt at merchandising his newly discovered flue pipe was with Ace Sheet Metal Works and was short lived (II. 537). His second attempt was with Dutton, who did business as the Standard Asbestos Co. Stadtfeld turned the invention over to Dutton and went to work for him on a salary (Fdg. 26). Dutton was not equipped to make the pipe economically and after a time told Stadtfeld he would turn over the invention to anyone who would buy up his \$3500 of stock (Fdg. 29). Stadtfeld's third attempt was with appellant, who hired Stadtfeld on a salary with the understanding "that something would be worked out if a patent were secured" (Fdg. 41). Appellant also knew that Dutton's stock had to be taken over to get title to the invention (Fdgs. 31, 32). In spite of the advice of appellant's patent attorney that there was a possibility of securing a patent on the Stadtfeld flue pipe, appellant refused to spend the money to do it (Fdgs. 37, 39).

"Stadtfeld was penniless and had exhausted his funds during many years of experimenting with different flue pipes leading up to the perfection of the flue pipe of the patent in suit, and was not in a position to finance an application for patent when Payne decided to ignore the invention and not take over Dutton's rights, in spite of the fact that Payne's attorney, Mr. Connor, had indicated that a limited patent might be obtained" (Fdg. 42, I. 58). "Stadtfeld for a time protested to defendant, but to no

avail" (Fdg. 43, I. 58). He had visions of losing the highly successful product of his years of experimenting and personal sacrifices.

"Stadtfeld, knowing that Payne had not taken over all of Mr. Dutton's stock so as to be entitled to Dutton's rights in the invention and the trade mark 'Metalbestos', and knowing that Payne did not intend to secure a patent on his invention, resigned from Payne's employ on September 1, 1934, and returned to San Francisco to see if he could interest some other manufacturer in Metalbestos" (Fdg. 44, I. 58).

Stadtfeld's fourth and successful attempt at realizing on his invention was with appellee. "Early in September, 1934, Stadtfeld called on Mr. Wallace, manager of plaintiff (appellee) company, and told him that Payne had decided not to acquire the rights in the invention and trade mark 'Metalbestos' from Mr. Dutton, and that these rights could be obtained from Mr. Dutton by plaintiff company" (Fdg. 45, I. 59). Appellee acquired title from Dutton and took steps to protect the valuable Stadtfeld invention (Fdgs. 47-49).

When appellee put its resources behind Stadtfeld and his invention, appellant realized it was no longer dealing with a helpless, penniless inventor but with a formidable rival who had the money to give the invention the protection it deserved (II. 382). *Appellant's interest in the patenting of the invention then suddenly revived.* In the winter of 1934 appellant's manager came to appellee with "a proposal to purchase the rights plaintiff (appellee) had secured from Dutton \* \* \*, but the offer made at this time

was turned down by plaintiff. At this conference Mr. Payne was advised by plaintiff that as soon as the patent was secured, plaintiff would expect defendant (appellant) to cease manufacture and sale of the pipe in suit" (Fdg. 51, I. 60). In the spring of 1935 Mr. Payne "again visited plaintiff (appellee) \* \* \* and admitted he 'slipped up on getting the rights from Mr. Dutton' and again proposed that plaintiff sell these rights to defendant. This offer was turned down" (Fdg. 55, I. 61). The patent issued September 3, 1935 and appellant was given written notice of its infringement on September 10, 1935. Nevertheless, appellant continued to infringe and this suit became necessary.

Caught redhanded in its infringement, the defenses relied upon by appellant before this Court are solely of a technical nature. They depend upon an erroneous interpretation of the disclaimer and disappear entirely if the disclaimer is read correctly. The prior art defense has no merit because not one of the devices relied upon could be used as a flue pipe, nor would it pass the building ordinances. There is no defense to the merits. Many of the principal arguments advanced in appellant's brief are predicated upon a misrepresentation of the facts. Appellant's counsel are perhaps not to be blamed because they only came into the case on appeal and are not as familiar with the facts as if they had helped make the record. *The case presents an aggravated instance of a ruthless manufacturer first trying to do the inventor out of his invention and then, when it gets into the strong hands of a competitor, of trying to buy the invention, and then, when refused, of stubbornly insisting upon appropriating the highly meritorious patented invention on the possible chance of an inadvertent decision.*

The first technical defense asserted is about the disclaimer. Appellant contends the effect of the disclaimer was to add elements to the three elements in the claim. Appellant's argument ignores completely the existence of the Supreme Court rule under which the disclaimers were modeled and prepared; and also ignores completely the fact that after the disclaimer, as before, the flue pipe claimed has only three elements,—the inner and outer pipe and the insulation . There is no element the disclaimer could have added because the three elements constitute the complete invention. What the disclaimer does do is to introduce structural limitations for each of the three elements, but that has always been considered a proper use of the disclaimer statute (see p. 25, *infra*). Each of appellant's alleged disclaimer arguments proceeds from a false premise and in disregard of long established, well-known principles of patent law. Taking the law applicable and the facts as they are in the record and as the trial court found them, there is clearly no error in its findings Nos. 7, 8, 9, and 22, that the disclaimer was a proper one.

The second technical defense asserted is that the prior art taught the invention. Appellant devotes very little space to this alleged defense because, having imitated the invention and not the prior art, there is nothing effective it can say. Its acts speak louder than any words it might utter. Appellant combed the prior art, but failed to discover there any disclosure of the invention. *It has no answer to the fact that it cannot successfully adopt any of the prior art devices in lieu of the invention in suit, or to the fact that the prior art devices are not acceptable under any building ordinances.* The answer is that they are not like the invention in suit.

Appellant's efforts to argue from the prior art run squarely into the comments of the Supreme Court in the case of *Diamond Rubber Co. v. Consolidated Tire Company*, 220 U. S. 428 at 441:

“The prior art was open to the Rubber Company. That ‘art was crowded’, it says, ‘with numerous prototypes and predecessors’ of the Grant tire, and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tires. *And yet the Rubber Company uses the Grant tire. It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation as others have done. And yet the narrowness of the claims seemed to make legal evasion easy. Why, then, was there not evasion by a variation of the details of the patented arrangement? Business interests urged to it as much as to infringement. We can find no answer except that given by the Tire Company: ‘The patented organization must be one that is essential. Its use in the precise form described and shown in the patent must be inevitably necessary.’”*

We respectfully submit that there is no new point developed in appellant's brief which was not fully considered by the trial court before entering its findings. We welcome the opportunity of analyzing appellant's various super technical arguments. Their inherent unsoundness and lack of merit is easily demonstrated.

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#### TRIAL COURT'S FINDINGS.

An exceptionally complete set of findings were made by the trial court in deciding this case (I. 50). These meet

and dispose specifically of each and every point urged in appellant's brief and may be summarized as follows:

1. The flue pipe art is an old art (I. 52) and Stadtfeld's invention was substantial and important and solved a problem of long standing in that art (I. 53).

2. Stadtfeld was the first in the art to create a flue pipe structure containing the combination defined in each of the three claims, which was a substantial and meritorious advance over anything in the prior art and required inventive genius to produce (I. 51).

3. One of the principal merits of the invention is its simplicity. It was an arrangement of old elements which produced a new result (I. 53).

4. When it appeared to plaintiff that through inadvertence, accident or mistake the language of the claims was of undue breadth and permitted an interpretation broader than was intended, proper qualifying disclaimers were filed. The effect of these was to modify the three elements of each claim *without adding new elements*. Each modifying limitation was taken directly from the specification of the patent as originally filed. Each claim, after disclaimer, as before disclaimer, had only three elements (I. 51).

5. Appellant's flue pipe is admitted to come within these claims, therefore infringement is not an issue (I. 50, 51).

6. The claims, either before or after disclaimer, are not like any claim (e.g. claim 8) abandoned during prosecution of the application (I. 51).



7. The claims, after disclaimer, as before, cover a single section of pipe and not a plurality of sections (I. 51).

8. The claims, after disclaimer, as before, do not call for an aggregation, but are for a patentable combination (I. 54).

9. Each of the prior art patents fails to disclose one or more of the elements of the claims or any equivalent thereof, and fails to show any prior invention, knowledge, use, or patenting (I. 52) of the Stadtfeld invention.

10. Each of the alleged prior uses by Baker, Shearer, and Evans fails to disclose one or more of the elements of the claims or any equivalent thereof, and fails to show any prior invention, knowledge, or use of the Stadtfeld invention (I. 52).

11. None of the prior art structures shown in any of the defendant's exhibits contains or discloses a flue pipe made in relatively short sections, each section being composed of an inner and outer tube separated and supported concentrically by layers of insulating material and having the adjacent ends of these pipes with male and female construction with the male end of the inner tube pointing downwardly and the male end of the outer tube pointing upwardly and having the tube slidable so that when a plurality of sections are joined together, the inner joined sections are supported independently of the outer joined sections (I. 52).

12. Stadtfeld made the invention in the fall of 1932, made an experimental elbow in late 1932, and made the first samples of the straight pipe in February, 1933, while

working for the Plant Rubber and Asbestos Company. None of these events occurred while Stadtfeld was in the employ of defendant, nor were any of the materials used paid for by defendant (I. 54).

These findings are controlling upon this appeal unless the Court finds them "clearly erroneous" (Rule 52a of the Rules of Civil Procedure). Each of the findings is supported by the overwhelming evidence and they may not be disregarded.

There were many express findings on facts (Nos. 24 to 56) about the alleged license or shopright defense and their correctness is not questioned by appellant. While appellants suggests (pp. 8, 9) that it will go into this defense, it abandons it by failure to discuss the facts and evidence. Likewise it abandons point No. 6 (p. 10) by failure to discuss it in the brief.

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#### THE PATENTED INVENTION.

For the convenience of the Court, an illustrative chart based on Plaintiff's Exhibit 18 (III. 672) is mounted on the inside back cover to remain unfolded and readily available for reference during the reading of this brief. If consulted at this time, reading from bottom to top, the significant features of the invention and its operating environment can be readily seen.

The patent (III. 636) shows in Fig. 1 three sections of the flue pipe with the parts broken away, where the two lower sections are joined, to show the nature of the joint.

Each sectional unit employs an inner tube 1 which is “made preferably from aluminum or other suitable material”. Around tube 1 is positioned a number of windings of layers 2 “of heat insulating material which has a plurality of air cells 3 running longitudinally there-through.” Located around the layers 2 and in contact therewith is an outer pipe 4 “made from galvanized sheet iron or other suitable material”.

One end of each pipe is crimped, the outer pipe at 4' and the inner pipe at 1' so as to provide male ends. The opposite end of each pipe left untouched provides a female end. Each section is assembled with the male end 1' of the inner pipe adjacent the female end of the outer pipe. This arrangement places the male end of the outer pipe adjacent the female end of the inner pipe.

The inner pipe is slidable inside the insulation as shown by the dotted line projection in Fig. 3. The insulation, extending full length, within each section of pipe, acts as a guide to hold the two pipes concentric. The complete sectional unit comprises three elements,—the inner pipe, outer pipe, and insulation.

When an installation is to be made, and after the lowermost section of the pipe has been placed, the inner tube of the next section to be assembled is pulled downwardly into the position shown in Fig. 3 and the male end 1' of this inner section is inserted tightly in the female end of the lowermost section. *This joint is then inspected*, before the female end of the outer tube 4 (Fig. 3) is slid down onto the upwardly projecting male end 4' of the lower outer tube. The assembly of section after section of this flue pipe is accomplished by repetition of the above steps.

This construction provides an inner tube *insulated and spaced* from the outer tube and *slidable in the insulation*; and, when an inner and outer string of tubing is in place leak-proof joints are provided, preventing any liquid condensing on the walls from the gases in the inner tube from gaining access to the insulating material, and preventing rain and moisture on the outside of the outer tube from gaining access to the insulated material between the tubes. The slidable feature aids assembly and also permits unhampered independent vertical expansion or contraction of either string of tubing, without dangerous loosening of the joints.

The extraordinary merit in Stadtfeld's flue pipe was immediately recognized by all who saw it. Here was the flue pipe the trade had needed so badly and had been searching for so long. Appellant's advertisements paid significant tribute to the originality and accomplishments of the invention. One read: (III. 885)

“Trial installations will prove the following points:

1. Better and quicker draft.
2. Improved combustion.
3. Elimination of excessive condensing of combustion products.
4. Longer life of appliance.
5. Less fire hazard.
6. Lower installation costs.”

These uncontradicted statements coming from appellant point up some of the problems solved by this important invention.

## THE FLUE PIPE PROBLEM.

In the burning or combustion of a fuel, air combines with the fuel producing flame and heat. The *products of combustion* resulting therefrom are the unburned elements not consumed in the flame and include water, the deadly carbon monoxide gas, various acids, etc. To support combustion there must be a constant supply of fresh air and a constant withdrawal of these products of combustion. The flue pipe is the conduit used to accomplish these two things and to carry out of the building these moist, acid laden, deadly products of combustion, sometimes referred to as flue gases. The potential danger to public health and safety of an improper flue has led to very rigorous laws as to what can and cannot be used (II. 512, 571). As this discussion continues it will be realized why the Stadtfeld invention satisfied these laws and why the prior art devices are forbidden.

One important phase of the flue pipe problem was to obtain an adequate *self-induced* draft in the flue to insure entry of sufficient air to the burner to maintain combustion.

This required maintaining the flue gases in the flue pipe well above the dew point temperature (135-140°F.). If flue gases drop below the dew point in the stack two things take place: first, condensates (a liquid) form on the walls of the flue and flow back into the appliance, and second, the upward rush of air through the flue is halted, bringing a consequent reduction in the amount of fresh air sucked into the burner to maintain combustion. Such a condition of choked draft establishes a *floating flame*, which is easily blown out. Deaths due to gas poisoning have resulted from this condition.

Another phase of the flue pipe problem was to obtain a *quick draft* so that appliances such as a stove or water heater would quickly reach a safe burning condition as well as the most efficient operating condition. Earlier flue pipes, as well as the so-called patent chimneys,\* required a long warm-up period before the proper draft was established and were accountable for the dangerous gas smells noticed in the house (II. 572).

Another phase of the flue pipe problem from the standpoint of the manufacturer (primarily interested in the efficient useful consumption of the maximum number of B. t. u. (British thermal units) *in* the appliance it manufactures) was that *the temperature of the flue gases leaving the appliance outlet* should be as low as possible. This low limit was arrived at by measuring the temperature drop of the gases as they passed up the flue (e.g., 110°) and adding to this the dew point temperature (e.g., 140°),—for when exhausted from the appliance the gases must contain sufficient heat to maintain the stack temperature to the very top above the dew point. In the example the appliance outlet temperature is 250°.

The manufacturer was also interested in a flue which would operate with a *minimum of condensation*, for the less the condensate flowing down into the appliance, the less the problem of rust and deterioration of the appliance, the longer its life.

Another phase of the problem was *removal of fire hazard*, arising in other flue pipes from insecure joints, from rusting out of the flue due to the acid action of ex-

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\*A tile inner pipe with cemented joints and a metal outer casing (II. 567).

cessive condensation, from improper insulation, from a flue that would not warm up quickly, etc.

Allied with this problem was that of the *carbon monoxide deaths* resulting from the seepage of these deadly fumes into living quarters of dwellings. The demand of municipalities for a flue pipe which would put a stop to the many deaths from this cause was long a spur to the industry to develop a safe flue pipe.

Another phase of the problem was to devise a pipe which could be quickly, easily and safely erected at a minimum labor cost.

Another phase of the problem was to protect the insulation from condensates.

*These problems Stadtfeld's invention solved*, and everyone realized it. Today there does not exist another flue pipe so efficient or successful as the pipe of the patent in suit.

On the record there is no room to dispute the radical novelty and patentability of the invention made by Stadtfeld. Its utility and value must be conceded, because appellant makes a "chinese copy" of Stadtfeld's invention, and although giving its praise to the prior art, it does not use the prior art.

*Sandy MacGregor Co. v. Vaco Grip Co.*, 2 F. (2d) 655, 656 (C. C. A. 6);

*Sachs v. Hartford*, 47 F. (2d) 743, 746, 747 (C. C. A. 2).

Its novelty cannot be disputed because:

Stadtfeld was the first to devise a flue pipe of metal or any other suitable material which gave a *quick rise in*

*stack temperature,—four or five times faster than other flue pipes (II. 515). The draft was established almost immediately (II. 515). This was a new result.*

Stadtfeld was the *first to teach the importance* in such a flue pipe of *insulating the inner tube* in order to maintain high stack temperatures. *This led to a new method of functioning.*

The gas appliance manufacturer now could design appliances to use up more of the b. t. u. s for useful purposes because *less heat was consumed in the stack to maintain a draft*. This meant more efficiency and economy in fuel consumed (II. 515).

Stadtfeld was the first to solve *the condensate problem*, which he did by so well insulating the inner pipe carrying the gases that the inner pipe wall temperature almost *immediately* rose above the dew point and thereby eliminated any chance for the gases to condense thereon. *This was a new concept,—putting the insulation directly around the pipe carrying the flue gases to keep the pipe hot.* Earlier workers in this art has missed that point entirely, and as shown by the abandoned Los Angeles pipe (infra, p. 56), were going on a theory the *very antithesis of Stadtfeld's*, namely, to have air contacting directly against the outside of the inner pipe carrying the flue gases and to apply the insulation on the outer tube so that if the latter became overheated it would not set fire to the building.

Stadtfeld was the first to combine in a flue pipe sectional independently connected and supported tubes having *insulation in between the two tubes* and forming at each end of the composite tube sections *a male and female end suit-*



able for connecting complementary ends to each adjacent composite section. This provided leak-proof joints.

Stadtfeld was the first to devise in this combination *the sliding of the inner tube with relation to the outer tube* so that it was possible to slide the inner tube down and make the joint with the next lower inner tube, before the outer tube was lowered to complete its joint with the lower outer tube. This speeded up installation *three or four times faster than other flue pipes* (II. 515) and made possible the inspection of every joint as the flue was assembled, section by section, on the job. *Its method of installation was new.*

Stadtfeld was the first to devise flue pipe units composed of relatively short slidable sections so that the inner string of tubing could be *joined and supported independently* of the outer string of tubing and in which these concentric tubes were *spaced and insulated* from each other by layers of air cell asbestos wound between them.

The trial Court found (Fdg. 12, I. 51) that Stadtfeld made “a substantial and meritorious advance over anything found in the art”; that it “required inventive genius to produce”; and (Fdg. 16, I. 53) that his invention “has solved a problem of long standing in that art and has gone into wide and successful commercial use”. Nothing advanced in appellant’s brief shows any error in the District Court’s findings.

The patent in suit contains a clear cut disclosure of Stadtfeld’s flue pipe invention, comprising the three elements,—the outer tube, the insulation and the inner tube slidable within the insulation. It explains fully the con-

struction of these three elements and their assembly into a unit so that the units can be put together section on section to make a complete flue pipe. The application for patent encountered the usual rejections and amendments. No concession was ever made that any of the references cited anticipated the invention.

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**THE DISCLAIMERS.**

(III. 638)

By the disclaimers which have been filed the patentee has merely done that which the statutes specifically authorize him to do, that is, to "make disclaimer of such parts of the thing patented as he shall not choose to claim or hold by virtue of the patent", provided that the part retained "is a material or substantial part of the thing patented and definitely distinguishable from the parts claimed without right".\*

The part retained by Stadtfeld is definitely distinguishable from the parts disclaimed for the reason that *the part retained is the thing fully and clearly illustrated in the drawings of the patent and fully and specifically described in the specification of the patent. It is merely any supposed equivalents that are disclaimed.*

The patent in suit presents a simple and typical case of an inventor inadvertently claiming more than that of which he was the original or first inventor or discoverer. The patentee, with the usual and natural enthusiasm of an inventor and lack of technical knowledge of claims,

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\*U. S. Code Title 35, Secs. 65, 71.

accepted the claims in their broadest form. During preparation of the case for trial it seemed that the *language* of the claims, rather than the spirit of the invention, reached out and included a wider range of equivalents than it now appears he was entitled to. Following approved practice, he filed "a precautionary disclaimer" (*Permutit v. Wadham*, 13 F. (2d) 454 (C. C. A. 6)), so that there would be no opportunity for contending that the claims were to be read or construed as covering any invention different than that disclosed in the specification and drawings.

The Court below in upholding these disclaimers made the following findings:

7. The claims of the patent in suit were narrowed in scope by qualifying disclaimers filed in the United States Patent Office on February 25, 1938, pursuant to U. S. Revised Statute Section 4917, when it appeared to plaintiff that through inadvertence, accident or mistake their language was of undue breadth, and permitted an interpretation broader than was intended. Each limitation was taken directly from the specification of the patent as originally filed and each only modifies the three elements of the claims without adding new elements.

8. The claims, as narrowed in scope by the qualifying disclaimers, accurately describe the composite pipe construction sold by defendant.

9. The claims, after disclaimer, as before, cover a single section of pipe and not a plurality of sections.

That these findings are correct will now appear.

The patent contains 3 claims, each patentably distinct from the other (Fdg. 21, I. 53). Claim 3 can be taken as representative.

Claim 3 before disclaimer read as follows:

**Introductory**

- Clause** "A composite pipe construction comprising
- Element 1.** an inner core pipe,
- Element 2.** an external pipe spaced from the inner pipe, and
- Element 3.** insulating material interposed between the two pipes, the said pipes being *telescopically* arranged with respect to one another."

By the disclaimer (III. 638) the following structural limitations were placed on the three elements:

**Introductory Clause Limited**

The introductory clause of the claims was limited so the recited three elements were claimed only where used

"for composite sectional pipes for conducting 'fluids or gases of combustion'".

Note: This had the effect of setting the claimed three elements apart from non-analogous prior art such as hot air pipes, underground cable conduit, etc. and limiting these three elements to use in flue pipe units. See Metropolitan decision, *infra* p. 33, limitation d.

**Elements 1 and 2 Limited**

The structure of the inner core pipe (element 1) and the external pipe (element 2) originally were not limited

in the claim to any particular form and could be of any form throughout their length or on their ends. The specification and drawings showed the construction of each formed with male and female ends and set opposite end to. The disclaimer merely introduced this same structural limitation from the specification into the claims (*Sachs v. Hartford*, 47 F.(2d) 743, 746 (C. C. A. 2). It read:

“*except when* ‘adjacent ends of the inner and outer pipes of each section’ have

‘male and female’ ends with

the male ‘end of the inner pipe’ ‘located adjacent the female end of the outer pipe’, and

‘with the male end of an inner tube pointing downwardly and’

*adapted to be* ‘fitted inside the female end of the adjoining lower section’

so that ‘any condensates forming inside the said inner pipes are carried over the joint’, and

‘with the male end of’ the ‘outer pipe of a section pointing upwardly and’

*adapted to be* ‘located inside the female end of the next higher pipe of another section,’

so that ‘a joint is provided which sheds any exterior moisture running downwardly over the outer pipes,’ and

the completed joints between ‘adjacent ends’ of adjoining sections

‘of the inner and outer pipes’ are in substantial radial alignment, and \* \* \*”

Note: These structural limitations relate solely to the forming and arrangement of elements 1 and 2 and

bring in no new elements. This is obvious because no new parts are added. Only parts already in the claim are modified. The pipes are changed from a general class to a specific type. (See Supreme Court rule *infra* p. 26.)

The important relationship of free slidability of elements 1 and 2 is further stressed by the disclaimer in the following functional statement about these elements.

“except when each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship”.

#### **Element 3 Is Limited**

The final structural and functional limitation introduced by the disclaimer is to specify that the third element “insulating material” shall provide

“an intermediate filler”.

Note:—This functional statement merely specifies one of the offices performed by the third element. See Metropolitan decision *infra*, p. 33, limitation f.

In view of the clear showing in the drawings and the description in the specification, it might well have been argued that the original claims carried these structural limitations by inference because a claim must be read and construed in the light of its own specification.

“The true rule is that the specification of a patent, which forms a part of the same application as its claims, must be read and construed with them \* \* \* for the purpose of ascertaining their true meaning and the actual intention of the parties when they

were made and allowed. *Seymour vs. Osborne*, 11 Wall. 516, 547.”

*O. H. Jewell Filter Co. v. Jackson*, 140 Fed. 340, 344 (C. C. A. 8).

However, the patentee and his assignee recognized the possible ambiguity of the claims as to whether they were or were not definitely limited to the particular three elements of the structure described and they recognized that, if they should be construed as not so limited, they might be broad enough to reach devices of which the patentee was not the original or first inventor. To avoid this possibility and to remove the possible ambiguity the “precautionary” disclaimers as to these claims were filed.

The propriety of disclaimers serving merely to remove ambiguity is well recognized (*Carnegie v. Cambria*, 185 U. S. 403, 436); especially where “the disclaimer goes no farther than to limit the claim to the disclosure, abandoning any implied and undescribed scope” (Judge L. Hand in *Sachs v. Hartford*, 47 F. (2d) 743, 746, C. C. A. 2). When the disclaimer is recorded it

“becomes a part of the original specification, and must be taken into account in construing the patent and in ascertaining the rights of the parties to the suit. \* \* \* The only effect of the disclaimer in such a case is to limit the nature of the invention secured by the patent and to diminish the claims of the patent as set forth in the specification.” (*Dunbar v. Myers*, 94 U. S. 187, 193, 194).

The attitude of the courts with regard to limiting disclaimers is well stated by this Court in *Carson v. Ameri-*

*can Smelting & Refining Co.*, 4 F. (2d) 463, 469, 470 C. C. A. 9), where the Court said: (p. 469)

“If such was the scope of his invention, *we are unable to see why he could not by disclaimers clarify his claim and render more certain that which he had invented.*”

And again, on page 470:

“Numerous other decisions trend to the doctrine that the *right of disclaimer* is remedial, and is *entitled to a liberality of treatment*, so long as the claim is not mutilated, *and nothing new is imported into it*, and no deception or fraud is practiced.” (Citing authorities).

This brings us then to a consideration of the erroneous arguments advanced by appellant in its scramble to escape the consequences of its deliberate adoption of the invention in suit. Appellant’s arguments will be answered in the course of our argument under the following headings:

#### SUMMARY OF ARGUMENT.

1. A patentee is entitled to use the disclaimer statute to limit the claims and elements in the claims “to a specific type of the general class” as the Court below correctly found. (Post pp. 25-28.)

2. The Stadtfeld disclaimer did not add an element to the claims therefore it is for the same combination and the Court below correctly found this to be the fact. (Post pp. 28-36.)



3. The disclaimer did not make the claims coextensive with any rejected claims or amount to reclaiming rejected subject matter and the Court below correctly found this to be the fact. (Post pp. 36-38.)

4. The disclaimer did not change the claims to cover a plurality of sections of pipe and the Court below correctly found this to be the fact. (Post p. 39.)

5. A proper limiting disclaimer does not require re-examination of the claims, and is not an evasion of the Reissue Statute. (Post pp. 39, 40.)

6. Filing a limiting disclaimer is not an admission that the original claims were invalid. (Post pp. 41-42.)

7. There was no unreasonable delay in filing the disclaimer as the Court correctly found. (Post pp. 42-44.)

8. The patented invention was novel and it is not disclosed in the prior art, as the trial court correctly found. (Post pp. 44-63.)

9. The Stadtfeld original claims 1, 2 and 3 and cancelled claims 3, 4, 5 and 8 are not prior art and cannot be used to anticipate the patent. (Post pp. 63-67.)

10. The claims are for a patentable combination and not an aggregation, as the trial court correctly found. (Post pp. 67-69.)

**1. A PATENTEE IS ENTITLED TO USE THE DISCLAIMER STATUTE TO LIMIT THE CLAIMS AND ELEMENTS IN THE CLAIMS "TO A SPECIFIC TYPE OF THE GENERAL CLASS", AS THE COURT BELOW CORRECTLY FOUND.**

Appellant's whole argument about the disclaimer ignores completely any reference to the long line of cases

which are really determinative of the present controversy and appellant seeks to give the impression that the law is different than it is. Nowhere does appellant indicate that there is a rule of law which permits a patentee to do what was done in the present case and *use the disclaimer statute to introduce limitations into the claims to make elements specific instead of general*. Instead, appellant cites only the line of cases dealing with attempts to use the disclaimer statute to introduce additional elements into the claims. There is a very distinct zone separating these two lines of cases. Both are good law and which is applicable depends upon the facts in each case. The present point we make is that the Supreme Court rule and the rule of the various Federal Courts is that:

“The use of the disclaimer has been upheld where the elimination from the patent of the matter not relied upon did not operate to enlarge the monopoly of the patent, but narrowed it, as \* \* \*

“by *limiting the claim to a specific type of the general class to which it was applied*. *Minerals Separation v. Butte & S. Min. Co.*, 250 U. S. 336, 354, 63 L. Ed. 1019, 1027, 38 S. Ct. 496; *United Chromium v. International Silver Co.*, 60 F. (2d) 913, 914 (C. C. A. 2d); *Seiberling v. John E. Thropp’s Sons Co.*, 284 F. 746, 756, 757 (C. C. A. 3d).”

*Altoona Pub. Theatres v. Am. Tri-Ergon Corp.*, 294 U. S. 477, 490 (Footnote 3).

In the *Minerals Separation* case, referred to by the Supreme Court, the claim before disclaimer called for “a small quantity of oil”. The disclaimer limited the amount of oil “to a fraction of 1%”—a specific amount. In the

*United Chromium* case, the limitation introduced into the claims was that the radical must be regulated in maintaining the efficiency of the bath. The claim originally called merely for the bath and the disclaimer introduced the above limitation for regulating the bath. In the *Seiberling* case, the four elements of the original claim were limited by the disclaimer to a machine which was only:

“constructed and co-ordinated for *shaping and applying* a previously unshaped sheet fabric strip to that part of the recited ring core beyond the tread portion and unless the power drive for the ring core functions by a sufficiently high speed of rotation and consequent centrifugal force to throw the unapplied fabric portion out from the side of the ring core, while the recited spinning roll in its radial movement, and while pressed toward the ring core, functions by a gradual action upon such centrifugally thrown-out fabric to shape it to the side of the rotating ring core while bringing it into adhesive contact therewith.”

(p. 757).

These instances referred to in the Supreme Court's own note are a few of many cases which prove the fact that the Courts all recognize that a *patentee is entitled to use the disclaimer statute to limit the claims to a specific type of the general class*. In each of these cases referred to the respective defendants, as they always do in any disclaimer case, made the argument that the disclaimer introduced new elements, but as Judge Learned Hand said in the *United Chromium* case, “Much of the defendant's argument depends upon an *illegitimate inference* from the disclaimer \* \* \*” (p. 914). “We do not, however, agree that a disclaimer has the effect asserted.”

The issue in the present case and in every case of a disclaimer which introduces new wording into the claims is whether that new wording imports into the claim one or more new elements, or whether *that wording introduces from the specification merely limiting statements about the elements already in the claim*. This issue was put squarely before *the District Court* and it *made its finding that Stadtfeld's disclaimer did not add an element to the claims but merely limited or modified the three elements already in the claims*, for the claims before and after disclaimer consisted only of three things,—the outer pipe, the inner pipe, and the insulation. The disclaimer simply particularized as to each of these three elements by “exclusion of part of the field of equivalency which the original claim language might have included” (*Nelson v. Meyers*, 29 F. (2d) 968, 969 (C. C. A. 6)).

2. THE STADTFELD DISCLAIMER DID NOT ADD AN ELEMENT TO THE CLAIMS THEREFORE IT IS FOR THE SAME COMBINATION AND THE COURT BELOW CORRECTLY FOUND THIS TO BE THE FACT.

Perhaps the most satisfactory way to continue this disclaimer point and to refute appellant's erroneous arguments is to take a few cases which held that the particular disclaimers added elements and then take a few cases which held that the disclaimers merely qualified, particularized, or limited structurally the elements already in the claim. From these we submit the Court will see, as did the District Court, that the Stadtfeld disclaimer falls in the latter group and is a proper use of that statute. We can start with the principal case on which appellant relies,—the *Altoona* case, 294 U. S. 490, and get its facts

clearly in hand. From this case three things will become apparent: first, that the *Altoona* disclaimer added an element,—a flywheel; second, that because of this fact it is distinguishable from the *Stadtfeld* disclaimer which merely particularized about the elements; and third, the Supreme Court in a footnote recognizes the line of cases sanctioning the *Stadtfeld* type of disclaimer.

In the *Altoona* case claim 13 had four elements. The disclaimer added to these elements “a flywheel”.

**The claim's elements**

**The disclaimer**

- |   |   |
|---|---|
| <p>(1) a photoelectric cell</p> <p>(2) means (a feeding device) for imparting to the film a rapid and uniform motion longitudinally of the film past said cell,</p> <p>(3) a source of light, and</p> <p>(4) an objective lens.</p> | <p>(5) a flywheel operatively connected with the film through means which imparts uniformity of motion of the flywheel to the film.</p> |
|---|---|

The flywheel was a whole separate new part or element added to the four elements of the claim, making it a five element claim. It was not a structural limitation, qualification, or particularization of any element already in the claim. *It had no antecedent in the claim. This is the important thing to note.* The Supreme Court was careful to point out that, “While this (disclaimer) *statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent,* it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination” (p. 490).

By way of explaining what it meant to sanction and meant to condemn, the Supreme Court placed in a footnote (#3 on page 490), the four classes of situations where a disclaimer is proper. Class four (already quoted at page 26) approves "limiting the claim to a specific type of the general class to which it was applied". In other words, where an element or elements are in a claim in broad language, the patentee can relinquish this broad terminology and "restrict or curtail the monopoly of the patent" to a particular construction for elements broadly referred to. This is what Stadtfeld did. The important thing in any such case is that the elements of the "general class" made into a "specific type" by the disclaimer should have been in the claim to start with. In neither the *Altoona* case nor the other cases relied upon by appellant is this the fact.

The *Fruehauf Trailer* case, 67 F. (2d) 558 (C. C. A. 6) cited by appellant (p. 25) is another in which the disclaimer, instead of limiting elements already in the claim, introduced a new element. The claim and disclaimer are outlined below:

#### Claim 22

"Supporting mechanism for trailers, comprising

1. *guide members*.
2. *slide members* carried by said *guide members*.
3. a *supporting member* pivotally connected to said *guide member* and adapted for vertical swinging movement, said *supporting member* having

#### Disclaimer

"all supporting mechanism claimed—except that in which the slide members are adapted to be actuated by

- (6) a *portion of the tractor* when the same is backed under the forward end of the trailer to thereby move the slide members rearwardly and cause the supporting member to be

4. *traction wheels* or rollers at its lower end, and
5. *cooperating means* on said guide and slide members for guiding said supporting member in its swinging movements and for causing said supporting member to swing when said slide members are actuated.”

moved upwardly into in-operative position.”

This disclaimer was held defective because it added as an element the tractor not before in the claim. The Court can ascertain this easily by noting the five elements originally in the claims, no one of which provides an antecedent basis for the tractor.

The recent case of *Lowell v. Triplett*, 17 F. Supp. 996 (DC Md.) cited by appellant (p. 25) illustrates the application of both rules under consideration. As in the *Altoona* case and the *Fruehauf* case, the Court held that matter added to claim 1 by the disclaimer violated the Supreme Court rule about adding elements. However, in the same case the Court went on to consider and approve changes made in the other claims by disclaimers modelled on the Supreme Court rule about limiting elements to specific structure. There is no need to consider the limitations added to all the elements of the claim as one will serve to make clear the point, namely, that by disclaimer detail of structure can be added to an element already in the claim and not be considered as adding an element:

**One Element of Claim 3**

“separate means connected to each of said amplifying and rectifying means for eliminating the hum of said alternating current.”

**The Disclaimer as to said Element**

by including construction which connected “*the grid of the amplifying means to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current, and to elements connected between the ‘means for amplifying said signal energy at radio frequencies’ and the ‘means for rectifying said energy’ which prevent the passage of power supply frequencies.*”

The Court said (p. 1001):

“Defendants contend that these disclaimers render the claims invalid because they add a new element to each of the combinations described in the claims, namely, that the disclaimers operate to enlarge the claims in such fashion as to render both the old and the new claims invalid by virtue of the reissue statute.”

After referring to the *Altoona* case rule and its footnote, quoted p. 26, supra, the Court said:

“We find that the disclaimers have done nothing with respect to all other parts of all three claims except what is permissible, as we have just seen, *namely, limit the specific claim to a specific type of the general class to which it was applied.* If such were all that had been done in the *Altoona* case, the disclaimer, we must assume would have been valid,  
\* \* \*”

Let us examine the facts of one more of many like cases which have held valid a limiting disclaimer like *Stadtfeld's*.



In *Metropolitan v. Cleveland*, 36 Fed. (2d) 477 (C. C. A. 6), the court held *no new elements were added to the Torchio claim* and that all the disclaimer did was to add to the five elements already called for by the claim additional words of structural limitation taken from the patent specification. These words of structural limitation (noted by italics) removed from the five elements of the claim any uncertainty as to the breadth of interpretation the words of the claim were intended to have,—they simply scaled down its breadth, as in the Stadtfeld disclaimer.\*

**Claim 3 of Torchio Patent  
1,172,322:**

- “An electric cable, comprising
1. a sheath,
  2. a line conductor having a joint,
  3. a body of pervious insulating material inclosing said joint, the said sheath being removed for a distance sufficient to expose said pervious body,
  4. a sleeve of impervious material of greater diameter than said body, inclosing the same and hermetically united at its ends to said cable sheath, and
  5. an insulating fluid adapted to permeate said pervious body contained in the space between said body and said sleeve.”

**Torchio Disclaimer**

Hereby makes disclaimer of the improvement described except for electric cables, which comprise,

- (a) a line conductor
- (b) insulating *wrappings* permeated with insulating compound, and
- (c) a sheath of *flexible inelastic metal* constituting
- (d) *a unitary product of manufacture and commerce which is portable and capable of being drawn through conduits; and*
- (e) except as to an insulating liquid *which is fluid at ordinary working temperatures of such cables and*
- (f) *in quantity sufficient to supply at all times the demands made by the cable in use, and by the joint.”*

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\*The patent in suit was subsequently held invalid by the United States Supreme Court in a later case on the basis of new prior art, but no question was raised by that Court as to the propriety of the disclaimer. (292 U. S. 69).

The Sixth Circuit Court of Appeals held the claims as modified by the disclaimer to be valid and infringed. As to the disclaimer it said (pp. 478, 479):

“The record carries no suggestion of any intent to broaden the claims beyond the specification (tit. 35, Sec. 65, U. S. C.), or any idea of obtaining the benefit of a reissue. *We think the effect of the disclaimer is to clear up an awkwardly worded, and therefore a somewhat ambiguous, description in the specification.* See *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 436, 22 S. Ct. 698, 46 L. Ed. 968; *Simplex Ry. Appliance Co. v. Pressed Steel Car Co.* (C.C.A.) 189 F. 70, 72. We also think that the disclaimer was not unreasonably delayed. As stated in *Sessions v. Romadka*, 145 U. S. 29, 12 S. Ct. 799, 801, 36 L. Ed. 609: ‘*The power to disclaim is a beneficial one and ought not to be denied except where it is resorted to for a fraudulent and deceptive purpose.*’ In *Excelsior Furnace Co. v. Williamson Heater Co.*, 269 F. 614, 619, (C.C.A. 6), the disclaimer was allowed after decision on appeal. See, also, *N. O. Nelson Mfg. Co. v. F. E. Meyers & Bro. Co.*, 29 F.(2d) 968, 969 (C.C.A. 6). The view we take is that the *matter* of disclaimer was within the discretion of the patentee to be reasonably exercised—‘a matter of policy’—*Permutit Co. v. Wadham*, 13 F.(2d) 454, 457 (C.C.A. 6), and we think there was sufficient doubt as to whether claims 3 and 4, as originally written, were anticipated to justify the seeming delay. Walker on Patents (2d Ed.) §255.”

This same type of disclaimer has been employed in many other cases and has met with the approval of the courts.

Appellant's only hope of succeeding on the alleged disclaimer defense is for this Honorable Court to inadvertently confuse cases of *particularizing about* or *qualifying an element already in the claim by specifying structure, with the other type of cases of adding an element.*

The courts, from the Supreme Court down, as we have seen, have placed their stamp of approval on disclaimers that merely qualify or particularize the structure of elements already in the claim, whereas the same courts have disapproved alleged disclaimers which added new elements to the claims. We have no quarrel with either line of cases. Both are good and correct law. Both make extremely important the fact determination by a court of the issue: Does the disclaimer merely qualify or particularize the structure of elements already in the claim, or does the disclaimer bring new elements into the claim? On this fact determination lies the whole of the present case.

The District Court very carefully distinguished between those two fact situations and found that plaintiff's disclaimer only particularized about the elements, that is, that it "modifies the three elements of the claims without adding new elements" (Finding No. 7); that after this disclaimer as well as before, the flue pipe claimed has just the three original elements,—the inner tube, the outer tube and the insulation. It is still for the same combination of three elements, but a limited kind of three elements as approved by the Supreme Court note in the *Altoona* case.

The analysis at page 20, *supra* demonstrates that every structural limitation introduced by the Stadtfeld disclaimer is taken directly from the specification of the

patent only to modify the three original elements in the claims without adding new elements.

Stadtfeld has done none of the things which have been held to be objectionable in disclaimers; he has not substituted an entire new claim; he has not added elements to make a new combination; and he has not included a feature not originally disclosed or clearly pointed out in the patent.

In this disclaimer, which merely restricts the elements of the claim to what is shown in the drawing and described in the specification, Stadtfeld has followed exactly the practice set forth and approved in many cases (Supreme Court note 3—*Altoona* case 294 U. S. 477, 490; *Minerals Separation v. Butte & S. Min. Co.*, 250 U. S. 336, 354; *United Chromium v. International Silver Co.*, 60 F. (2d) 913, 914 (C. C. A. 2); *Seiberling v. John E. Thropp's Sons Co.*, 284 Fed. 746, 756, 757 (C. C. A. 3); *Van Meter v. Irving Air Chute Co.*, 27 F. (2d) 170, 172 (N. Y.); *Permutit Co. v. Wadham*, 13 F. (2d) 454, 457 (C. C. A. 6); *N. O. Nelson Mfg. Co. v. F. E. Meyers & Bro. Co.*, 29 F. (2d) 968, 969 (C. C. A. 6); *Nelson v. F. E. Meyers & Bro. Co.*, 56 F. (2d) 512, 513 (C. C. A. 6); *Sachs v. Hartford*, 47 F. (2d) 743, 746 (C. C. A. 2); *Metropolitan v. Cleveland*, 36 F. (2d) 477, 478, etc.)

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3. THE DISCLAIMER DID NOT MAKE THE CLAIMS COEXTENSIVE WITH ANY REJECTED CLAIMS NOR AMOUNT TO RECLAIMING REJECTED SUBJECT MATTER, AND THE COURT BELOW CORRECTLY FOUND THIS TO BE THE FACT.

The contention by appellant (page 13) that Stadtfeld intended to omit from the patent franchise any claim

directed to the details of construction of the outer and inner tubes is without any basis in the record and is not the fact. Appellant, without any authorities in point, seeks to build this argument on cancelled claims 3, 4, 5 and 8, however. Appellant does not point out to the Court that the rejected claims 3, 4 and 5 (III. 694) never did contain one of the essential limitations, namely, slidability, which affected the allowance of the three claims in suit. Similarly, appellant does not point out to the Court that claim 8 (III. 698) contained only two elements, the inner and outer tubes and never contained the slidability functional limitation, nor the third element, insulation. *The cancelled claims were for entirely different combinations*, and any estoppel extends no further than to those cancelled combinations (*Johnson v. Philad*, 96 F. (2) 442, 444, 2nd column (C. C. A. 9). For appellant's argument to have any basis, the facts would have to be different, namely, either claims 3, 4, 5 or 8 would have had to call for the three elements of the patented claims plus the structural limitations of the original claims and of the disclaimer. A glance at the file wrapper (III. 694, 698) shows they never had such content. This blasts appellant's fact contention on this point. The same contention in a slightly different dress is discussed under point 9 at page 63, *infra*.

Furthermore, the impression appellant's argument tends to create is not the law. The cancellation of a claim during prosecution is not an admission that the structure set out in the cancelled claim is old in the art. "It is a declaration that that which is not claimed is *either* not the patentee's invention, or, if his, he dedicates it to the

public" (*Miller v. Bridgeport Brass* case, 104 U. S. 350, 352). He only concedes that he does not choose to assert further his claim to a monopoly on the particular combination of those cancelled claims. So, examining claims 3, 4, 5 and 8 we see that Stadtfeld dedicated to the public only the exact combination they describe.

This is the substance of the *Wilson v. Union Tool* case cited on page 13 by appellant and is good law, but that case does not support appellant's erroneous contention that the three element disclaimer claims with the two tube elements limited to having male and female ends are not valid claims. *At no time during prosecution of the case did Stadtfeld ever acquiesce in the rejection of a three element claim with the slidability limitation.* The structures relinquished in claims 3, 4, 5 and 8 omit the features of slidability and insulation which are an essential in the three patented claims (compare *Johnson v. Philad*, supra).

As granted by the Patent Office, claims 1, 2 and 3 were for three elements with the slidability limitation. There was no limitation on the form of the tubes, therefore the original scope of the claims would have covered male and female ends or both male ends or any kind of ends. The disclaimer voluntarily limited the tubes to those described in the patent having male and female ends. *The important thing is that the claims are not like any claim cancelled during prosecution.* Thus, appellant's pretended argument falls on both the facts and the law and no error whatever is shown in the trial court's finding No. 8 (I. 51).

4. THE DISCLAIMER DID NOT CHANGE THE CLAIMS TO COVER A PLURALITY OF SECTIONS OF PIPE INSTEAD OF A SINGLE SECTION AND THE COURT BELOW CORRECTLY FOUND THIS TO BE THE FACT.

The record refutes this contention of appellant (p. 23). The first portion of the disclaimer (see analysis p. 20, supra) limited the introductory clause by stating environment. Nowhere in the disclaimer is the word "plurality" used. What appellant does is to confuse statements of function where the disclaimer talks about the structural limitations made to the inner and outer tubes (page 21, supra) and pays no attention whatever to the words "adapted to be" occurring twice in that section of the disclaimer showing how it is adapted to be used. These are clearly words of limitation describing just one section of composite pipe "adapted to be" connected to other sections. For appellant's erroneous fact contention to be correct, these words as well as others would have to be omitted and many others added. Appellant has shown no error in the District Court's finding No. 9 that "the claims, after disclaimer, as before, cover a single section of pipe and not a plurality of sections".

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5. A PROPER LIMITING DISCLAIMER DOES NOT REQUIRE RE-EXAMINATION OF THE CLAIMS AND IS NOT AN INVASION OF THE REISSUE STATUTE.

At several places (pp. 4, 5, 10 and 15), appellant suggests that instead of a disclaimer Stadtfeld should have used the reissue statute. The trouble with appellant's argument is that the facts of the present case don't bear out

its contention. If this case here were like the *Altoona* case where it was necessary to add the flywheel to the claim as an element, then reissue would have been the remedy. What appellant overlooks is that the *Stadtfeld* case falls within the limiting disclaimer statute and not the reissue statute because the three elements are already in the claim and it is only necessary to introduce structural limitations to these three elements. Appellant's is the stock argument made by every defendant in a disclaimer case.

“Defendant contends that plaintiff's disclaimers were not effective to accomplish the attempted changes in the claims in question, but presented a new and different cause of action, and that the only method of relief in that behalf open to Plaintiff was by application for a reissue. *We cannot assent to this contention.* Cf. *Excelsior Steel Furnace Co. v. Williamson Heater Co.* (C.C.A. 6) 269 F. 614, 619, et seq.; also *Michigan Carton Co. v. Sutherland Paper Co.* (C.C.A. 6) 29 F.(2d) 179, decided November 7, 1928. *The specifications of the two Meyers patents were in complete harmony with the claims as effected by the disclaimers.* No change of specification was made or needed. The disclaimer was not a confession of anticipation in the absence of disclaimer. *Permutit v. Wadham* (C.C.A. 6) 13 F.(2d) 454, 457. As in the *Permutit* case, *the disclaimers operated to limit the claims, not by the inclusion of a new element, but by the exclusion of part of the field of equivalency which the original claim language might have included.* We think the disclaimer must be accepted as effective.” (969)

*N. O. Nelson Mfg. Co. v. F. E. Meyers & Bro. Co.*,  
29 Fed. (2d) 968 (C. C. A. 6);

See also *Lowell v. Triplett*, supra p. 31.



6. FILING A LIMITING TYPE DISCLAIMER IS NOT AN ADMISSION THAT THE ORIGINAL CLAIMS WERE INVALID.

Appellant makes a fundamental error which runs throughout its brief (pp. 3, 6, 8, 10, 27, 30, 34, 36) to the effect that the filing of a disclaimer amounts to an admission that the claims before disclaimer were invalid. The law is otherwise. In many cases, as here, the disclaimer was filed out of an abundance of caution and not because there was any prior art that disclosed Stadtfeld's invention. As practical proof of the fact that there is no anticipating prior art, is appellant's own inability to leave the Stadtfeld invention and take up a prior art device. *The filing of a disclaimer is held by the courts to give rise to no inference or admission that the claims were invalid without the disclaimer.*

In *Permutit Co. v. Wadham*, 13 F. (2d) 454 (C. C. A. 6), the Court said (p. 457):

"We do not understand that a disclaimer to avoid the supposed anticipating or limiting effect of some other publication is a confession that the patent would be void if the disclaimer were not made. *The patentee decides a question of policy*; he may think that, although the supposed anticipation can be successfully met and defeated, a disclaimer will not affect the real value of this patent, and to make it will save trouble and expense and do no harm. *We see no reason why he is not at liberty, after the disclaimer as before, to deny the anticipatory effect of the other matter*; and it has been so held. *Manhattan Co. v. Helios Co.*, 135 F. 785, 802" \* \* \* "So far as this record shows, *the case was thoroughly appropriate for a precautionary curative disclaimer.*"

In *Nelson Mfg. Co. v. F. E. Meyers & Bro. Co.*, 56 F. (2d) 512 (C. C. A. 6), the Court said (pp. 512, 513):

“The motion to dismiss was based upon the proposition, advanced in argument here, that original claims 7 and 1, were, not only admitted to be invalid by appellee when it filed its disclaimers, but were shown to be so by the new references. Upon that basis it is contended that the bill should have been dismissed by the lower court because the infringing acts relied upon were committed before the filing of the disclaimers. *We cannot agree that Dunbar v. Meyers*, 94 U. S. 187, 24 L. Ed. 34, the Packing Company cases, 105 U. S. 566, 26 L. Ed. 1172, and *Collins Co. v. Coes*, 130 U. S. 56, 9 S. Ct. 514, 32 L. Ed. 858, require the conclusion that the filing of the disclaimers was a confession that the original claims were invalid for anticipation. See *Permutit Co. v. Wadham*, 13 F.(2d) 454, 455 (C.C.A. 6), not reversed on this point in *Permutit Co. v. Graver Corp.*, 52 S. Ct. 53, 76 L. Ed. 163.”

Additional cases to the same effect are cited at page 65, *infra*, where appellant advances another erroneous contention based on a mistaken understanding of the law.

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**7. THERE WAS NO UNREASONABLE DELAY IN FILING THE DISCLAIMER.**

The contentions at this point in appellant's brief (pp. 36-39) are based upon a misapprehension of the law as well as a complete mistake and assumption as to the facts.

An absolute misstatement of fact occurs at the bottom of page 36 where appellant extends the same fun-

damental error of law just discussed under 6, to support without any justification an erroneous statement of fact that anticipation of the patent claims was admitted by appellee. No such admission was ever made. The authorities just quoted are enough to dispose of appellant's whole point (pp. 36-39), but there are other erroneous features in its argument that further destroy it.

For instance, not a single one of the cases cited by appellant (pp. 37, 38) involved a voluntary precautionary type disclaimer. They all were entirely different, non-analogous fact situations, where the claims had been held invalid by a court. If appellant had turned to the cases dealing with voluntary precautionary type disclaimers it would have found that the courts consider such a disclaimer is not unreasonably delayed even when made "after decision on appeal". "The view we take is that the matter of disclaimer was within the discretion of the patentee to be reasonably exercised—a matter of policy" (*Permutit Co. v. Wadham*, 13 F. (2d) 454, 457 (C. C. A. 6)), and we think there was sufficient doubt as to whether claims 3 and 4, as originally written, were anticipated to justify the seeming delay. *Walker on Patents* (2d Ed.), Sec. 255" (*Metropolitan v. Cleveland*, 36 F. (2d) 477, 479 (C. C. A. 6).) Certainly, Stadtfeld's disclaimer filed before trial is as timely as one filed after decision on appeal.

Another serious mistake of fact is where (p. 39) appellant says that its attorney, Connor, had reported "The pipe was not novel and patentable". The true fact is that Connor reported that in his opinion (III. 884) "there is a possibility of securing a patent".

The next error in appellant's argument (p. 39) is its erroneous assertion that knowledge of the existence of the O'Toole patent (see appendix p. v) would put Stadtfeld on notice that his claims were too broad. When Stadtfeld was shown the Connor report he read there that Connor thought a patent could be obtained because O'Toole failed to show "a double-walled pipe in which each wall had a joint independent of the other. Both Line and O'Toole bring their walls together to present but one pair of telescoping members at a joint", (III. 884) and, he could have added, that O'Toole rivets this joint so there is no slidability. In other words, the very slidable, double-walled pipe which Stadtfeld's patent specification and claims have always covered was admitted by appellant's attorney not to be found in O'Toole. Clearly, there is nothing about this patent to put Stadtfeld on notice that the claims which the Patent Office later granted should be narrowed by disclaimer.

In the record there is no showing whatever that the owners of the patent, before the disclaimer, or that the Patent Office, ever appreciated any undue breadth in the original claims. Appellant's argument is without any basis either in law or fact, and does not show any error in the trial court's finding of "inadvertence, accident and mistake". (I. 51).

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8. THE PATENTED INVENTION WAS NOVEL AND IS NOT DISCLOSED IN THE PRIOR ART AS THE TRIAL COURT CORRECTLY FOUND.

The record in this case demonstrates beyond doubt that Stadtfeld's flue pipe was totally new. The novel features

were reviewed at page 15, supra. At the trial a total of 21 prior art items were offered in evidence by appellant in an attempt to anticipate the patented invention or show lack of invention. They may all be read, and nowhere can there be found any teaching of Stadtfeld's discovery of how to make a successful flue pipe. *No one before Stadtfeld, although the means were at hand and the need was great, had had the mental picture of a new arrangement of pipes and insulation combined to function on a new principle and produce a new result.* No one before had taken the mental leap to this new arrangement and combination. Now that Stadtfeld's invention has been disclosed to the world it is an easy task to assemble every suggestion in this and other arts to create a suspicion of a general lack of novelty in what Stadtfeld did. This can be done in the case of any patented invention.

“The industrial and scientific problems which face mankind are being attacked all over the world by busy, inventive minds from the most varied points of view. When some lucky inventor has been successful in solving the problem and (whether for the purpose of action or otherwise) the records of past failures or incomplete success are searched, it is common to find that suggestions or adumbrations of each of the various steps by which he has achieved his result are to be found in some one or other of the works of those who have gone before him, and when such records are selected from a mass of antecedent publications and put in an isolated form before a court, there is a danger of their giving rise to a suspicion of a general lack of novelty in the successful invention. *But it must be remembered that*

these alleged prior publications are the product of a selection made with a knowledge of the successful invention, and that probably hundreds of proposals equally promising, but which point in wholly different directions, have been rejected in the search by reason that they do so.”

*Minerals Separation, Ltd. v. The British Ore Concentration Syndicate, Ltd., et al.*, 27 R. P. C. 53.

“The defendant assembles every similar device, description, or suggestion in the particular art not only, but also in analogous, and even in remote arts. Everything which has the least bearing upon the subject is brought in and arranged by a skillful expert in an order of evolution which resembles most closely the invention which is the subject of attack. Having thus reached a point where but a single step, perhaps, is necessary to success, and *knowing from the inventor exactly what that step is*, the expert is asked if the patent discloses invention, and honestly, no doubt, answers in the negative. There is always the danger, unless care is taken to divest the mind of the idea added to the art by the inventor, that the invention will be viewed and condemned in the light of ascertained facts. With his description for a guide, it is an easy task to trace the steps from the aggregation to the invention. When it is remembered that before Sir Humphrey Davy made his safety-lamp, wire gauze, and lanterns provided with perforated tin cylinders, were well known, it seems, in the light of the present, as if the idea of substituting the gauze for the perforated tin, being apparently so simple, might have occurred even to a skilled mechanic. So, too, moving the eye from the head to the point of a needle seems, in this age, but a trifling thing; and

yet, to the inspiration of genius which suggested these changes we are indebted for two inventions of inestimable value.”

*Johnson v. Forty-Second Street, M. & St. N. Ave. R. Co.*, 33 F. 499, 501.

Indeed, it is impossible to reconcile the important recognition given Stadtfeld's invention by the art, in fact by appellant itself in its own advertising, with the contention that he discovered nothing new.

Appellant's advertising is particularly significant because it stresses as novel the very features of combination which are lacking from the prior art and which Stadtfeld only discovered after years of labor with the flue pipe problem. Here are some samples of these advertisements by appellant-defendant which herald the novelty, efficiency, safety and lower installation cost of the flue pipe in suit:

“*A new type of gas vent and flue pipe*” (Def. Ex. 14A, III. 886).

“*New in design and construction, yet old in principle, this pipe is now offered to the trade as being the most efficient, durable and safe pipe on the market,—not ‘just another pipe’* (III. 885).

“*Metalbestos is the most efficient pipe because of its high insulating value, there being one-half inch of asbestos around inner pipe and fittings.*

“*It is safer because of its always cool outside surface which eliminates fire hazard, because its crimped opposite ends of inner and outer pipes and fittings make for leak-proof connections, and because the outside galvanized iron jacket protects the insulation*

against disintegration through exposure to moisture." (Def. Ex. 15A II. 885).

"It is *easily assembled* without the use of cement or other materials." (Def. Ex. 15B III. 887).

"Metalbestos is *without equal* as a pipe for venting gas appliances. The *use of aluminum pipe as a gas vent is not a new idea* as it has been used for years without failure from a corrodible standpoint. *Its shortcoming has been that due to its high rate of heat conductivity it has caused such rapid chilling of the products of combustion that condensation was excessive and draft conditions poor. We have taken advantage of the durability of aluminum and have overcome the obstacle of excessive heat loss by insulating the aluminum pipe comprising the inner tube of Metalbestos. The only real way to prove that it is all that we claim it to be, is to try it out on some of your jobs. You will be more than pleased with its performance and its low cost of installation.*"

(From one of 1000 letters to the trade—May 15, 1934—Def. Ex. 18, III. 897).

"Metalbestos Gas Vent and Flue Pipe, has *won such instant and hearty approval in all sections of the country. Our claims as to its superiority over all other commonly used gas vent pipes are amply borne out and we know that a few trial installations will convince you of its many advantages, including lower installed cost.*"

(From letter Aug. 1, 1934 to the Trade—Def. Ex. 18, III. 898).

"Payne-A-Vent\* *has been accepted by the trade as being, by far, the most efficient, durable and easily installed pipe on the market. The efficiency of Payne-*



A-Vent, from a draft standpoint, is insured due to the high rate of heat conductivity of the *aluminum plus the provided insulation*. The rapidity with which the inner tube heats up and conveys the heat from one section of aluminum pipe to the other, provides a *hot stack immediately*. This condition is greatly accelerated *due to the surrounding insulation*, which prevents the radiation of heat from inside the pipe. *A hotter stack, more immediate and perfect draft and consequently quicker and better combustion of fuel* is obtained through the use of Payne-A-Vent over any other commonly used type of gas vent or flue pipe on the market.”

(From Bulletin distributed by the thousands—Pl. Ex. 5 II, 640).

No court can overlook such praiseworthy statements as these by the infringer which call attention to the radical novelty of Stadtfeld’s invention and its ready acceptance by the trade to fill “*a long-felt want*”. Today it is filling a substantial per cent. of the market (II. 270).

In *Hiler Audio Corp. v. General Radio Co.*, 26 F. (2d) 475, 478 (Mass.), (no appeal), the Court had before it a device similar to the one in suit, in that the device was made up from elements all old in the art, and the defendant, caught red-handed, sought to invalidate the patent. Judge Brewster held the patent valid and infringed. On the point of defendant’s advertising he said (p. 478):

“*In its advertisement it would have the public believe that the infringing device is unique in design and performance*. It also, in its advertisements which it circulated, *enlarged upon the advantages of the infringing device*. These advantages were substantially

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\*Appellant’s new name for the flue pipe.

the same as those mentioned by Hiler in his application. Such *imitation ought to be given weight as evidence of what the defendant thinks of the patent, and persuasive of 'what the rest of the world ought to think'*. Kurtz v. Belle Hat Lining Co. (C.C.A.) 280 F. 277, 281.”\*

And similarly in *Mallinckrodt Chemical Works v. E. R. Squibb & Sons*, 6 F. Supp. 173, 175 (Mo.), affirmed 69 F. (2d) 685 (C. C. A. 8), the defendant's statements made in advertisements were held to outweigh its later plea of invalidity where (p. 175):

“\* \* \* it appeared from the evidence that the *defendant advertised its seal as an improvement and placed upon its can a statement that it too had applied for a patent.\** The defendant, under such circumstances, could hardly be heard to dispute the validity of plaintiff's patent. *David et al. v. Harris*, 206 Fed. 902; *Hiler Audio Corporation v. General Radio Co.*, 26 Fed.(2d) 475.”

The trial court found that Stadtfeld's flue pipe unit composed of an inner and outer tube separated and supported concentrically by layers of insulating material and having the adjacent ends of these pipes with male and female construction with the male end of the inner tube pointing downwardly and the male end of the outer tube pointing upwardly and having the tube slidable so that when a plurality of sections are joined together, the inner joined sections are supported independently of the

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\*Appellant, Payne, although refusing to go through with its agreement to patent the Stadtfeld invention, did nevertheless mark its pipe and literature with "PAT. APPLIED FOR" (Exh. 14 A III. 885) when in fact appellant had no patent pending.

outer joined sections, was novel and was not disclosed in the prior art (Findings Nos. 13, 14, 15, I. 52).

Appellant's brief (pp. 28-33) refers to but twelve of the many prior art items presented to the lower court. The remainder may be disregarded. Appellant argues that Stadtfeld did not discover or teach anything that was not as well disclosed by this prior art. It is only necessary to examine this art to see at once that this is not true. A most significant thing about appellant's discussion of the prior art is its complete inability to pick out any reference and say: "There is the Stadtfeld invention". Instead, appellant is only able to approach the Stadtfeld invention by a mosaic of the prior art,—by taking a little bit from this reference, a little bit from another, and so on. After several pages (pp. 31-33) of discussing what parts it will take from the various patents to make up the Stadtfeld invention, appellant ends up by admitting (p. 33) that what it proposes is for the Court to make a "selection of the preferred form of elements from old prior art structures". Such attempts at piecemeal anticipation of valuable inventions have never been approved by this Court or any other.

*"The defense offered is a mosaic defense and as was said by this court in Craft-Stone, Inc. v. Zenitherm Co., Inc., 22 F.(2d) 401, 'The patentee invented a new and useful product, and it is not permissible for an infringer to go to the prior art and defeat the patent by selecting the various elements of the patentee's process from different patents, bring them together, and say that this aggregation anticipates. Knowledge after the event is always easy, and problems once solved present no difficulties. Loom Co. v.*

Higgins, 105 U. S. 580, 26 L. Ed. 1177; Diamond Rubber Co., etc., v. Consolidated Rubber Tire Co., 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527.' ”

*Atlantic Refining Company v. James B. Berry Sons' Inc.*, 40 U. S. P. Q. 2, 6 (C. C. A. 3) (Decided Dec. 21, 1938).

“It is to be borne in mind that the prior art here relied upon consists entirely of patents, and that when it is sought by means of prior patents to ascertain the state of the art, *‘nothing can be used except what is disclosed on the face of those patents. They cannot be reconstructed in the light of the invention in suit, and then used as a part of the prior art.’* ” (Citing cases).

*J. A. Mohr & Son v. Alliance Securities Co.*, 14 F. (2d) 799, 800 (C. C. A. 9).

See, also, *Stebler v. Riverside*, 205 Fed. 735, 738 (C. C. A. 9).

The present problem facing this Court in examining the prior art is well expressed in *Railroad Supply Co. v. Hart Steel Co.*, 222 Fed. 261, 273, 274 (C. C. A. 7):

“Invention of a combination does not lie in gathering up the elements that are employed, but *consists in first conceiving that a new and desirable result may be attained by bringing about a relationship of elements which no one has before perceived* and then going forth to find the things that may be utilized in the new required relationship. *In an old and well-developed field the apparent simplicity of a new device is often the highest evidence of inventive genius.* So far as human minds are able, *judges should exclude from view the disclosure of the patentee, should regard the patentee's problem as of a time antedating*

the application, and should therefore *not too readily accept the ex post facto wisdom of the bystander. Prior art structures are to be examined in view of the purposes and laws of such structures. It is not enough that a prior art device approach very near the idea of the patent in suit; it must so clearly disclose the idea that it would be apparent to a mechanic of ordinary intelligence who was not examining the device for the purpose of discovering in it the idea of the patent. For, if he already had that idea, he would not be getting it from the prior art device, but from his own imagination or some other source.*"

The Court of Appeals for the Third Circuit also points out the great care which that Court exercises with prior art patents:

*"Now not only does every prior patent fail to show Peiler's combination, not only can such patents be used without infringing Peiler's claims, but it is clear that the glass art, which was frantic to get some machine to free them from Owens' domination, saw nothing in any of these prior patents, either in instruction or even suggestion, to enable the art to discover such a path as Peiler hewed out, much less, even by implication to suggest such a path. And where an art, eager for relief, found in these moribund patents nothing to meet that suggested solution, it is safer to rely evidentially on the then judgment, attitude and conduct of the glass trade, rather than on the post litem testimony of experts, the contentions of infringers, and the theoretical construction that often tempts courts to create out of lifeless patents an imaginary machine on paper which a working art could not do in steel."*

See *Hartford-Empire Co. v. Hazel-Atlas Glass Co.*, 59 F. (2d) 399, 413.

With one more short quotation from the Supreme Court bringing out a rule which this Court will find applicable as it examines the prior art in its relation to Stadtfeld's invention, we can pass on to that art.

“Where the thing patented is an entirety, consisting of a separate device or of a single combination of old elements incapable of division or separate use, the respondent cannot make good the defense in question by proving that *a part of the entire invention is found in one prior patent, printed publication, or machine, and another part in another, and so on indefinitely*, and from the whole or any given number expect the court to determine the issue of novelty adversely to the complainant. *Bates v. Coe*, 98 U. S. 31.

“Common justice forbids such a defense, as it would work a virtual repeal of so much of the Patent Act as gives to inventors *the right to a patent consisting of old elements*, where the combination itself is new and produces a new and useful result. *New elements in such a patent are not required*, and if such a defense were allowed, not one patent of the kind in a thousand of modern date could be held valid. Nor is such a defense consistent with the regulations enacted by Congress in respect to the procedure in litigations in respect to patent-rights.”

*Parks v. Booth*, 102 U. S. 96, 104.

Of all the art referred to in appellant's brief, only one patent (Savage) and one prior use (the abandoned, outlawed Los Angeles flue) have to do with flue pipe. The other items are entirely non-analogous art from which appellant plucks a piece of insulation or a piece of tubing with a crimped end, etc., in its endeavor to construct the

Stadtfeld invention from these lifeless, non-analogous patents.

*Savage Patent Exhibit 4-C, III. 718*). This patent was issued in 1893, about forty years before Stadtfeld made his invention. The device never was used and the reason why will be made clear by examining the drawings (*III. 718*). The inner tubes are spaced apart *vertically* from each other between sections and do not form a continuous walled passage, with the result that *condensate from the gases would flow directly into the exposed insulation* at the separated tube ends, and cause it to fall and leave an open space through which *the burned poisonous gas would flow into the room* (*II. 571*). For this reason alone *it would not pass inspection* of any building authorities (*II. 570*). Another reason it is impractical and won't pass inspection is the lack of connection between one section of inner tube and the next section (*II. 571*). The flue is assembled on the job, at which time the insulation is tamped in around the pipe without anything to assure centering of the inner tube, or that an equal amount will be tamped in on all sides. Practically, *the inner tubes would not be perfectly aligned, and the gases of combustion would exhaust into the insulation at each disaligned joint* (*II. 569*). Another reason it is impractical and won't pass inspection is the *lack of durability* (*II. 571*). Once the insulation is saturated with condensate it shrinks into a smaller volume. This would leave the inner pipes entirely unsupported and the net effect would be to disrupt the inner conduit for the poisonous flue gases. Appellant's assumption (p. 30) that the inner tube is slidable in the insulation is incorrect and departs from the record because the flange 2 (Fig. 1) positively prevents it (*II. 569*).

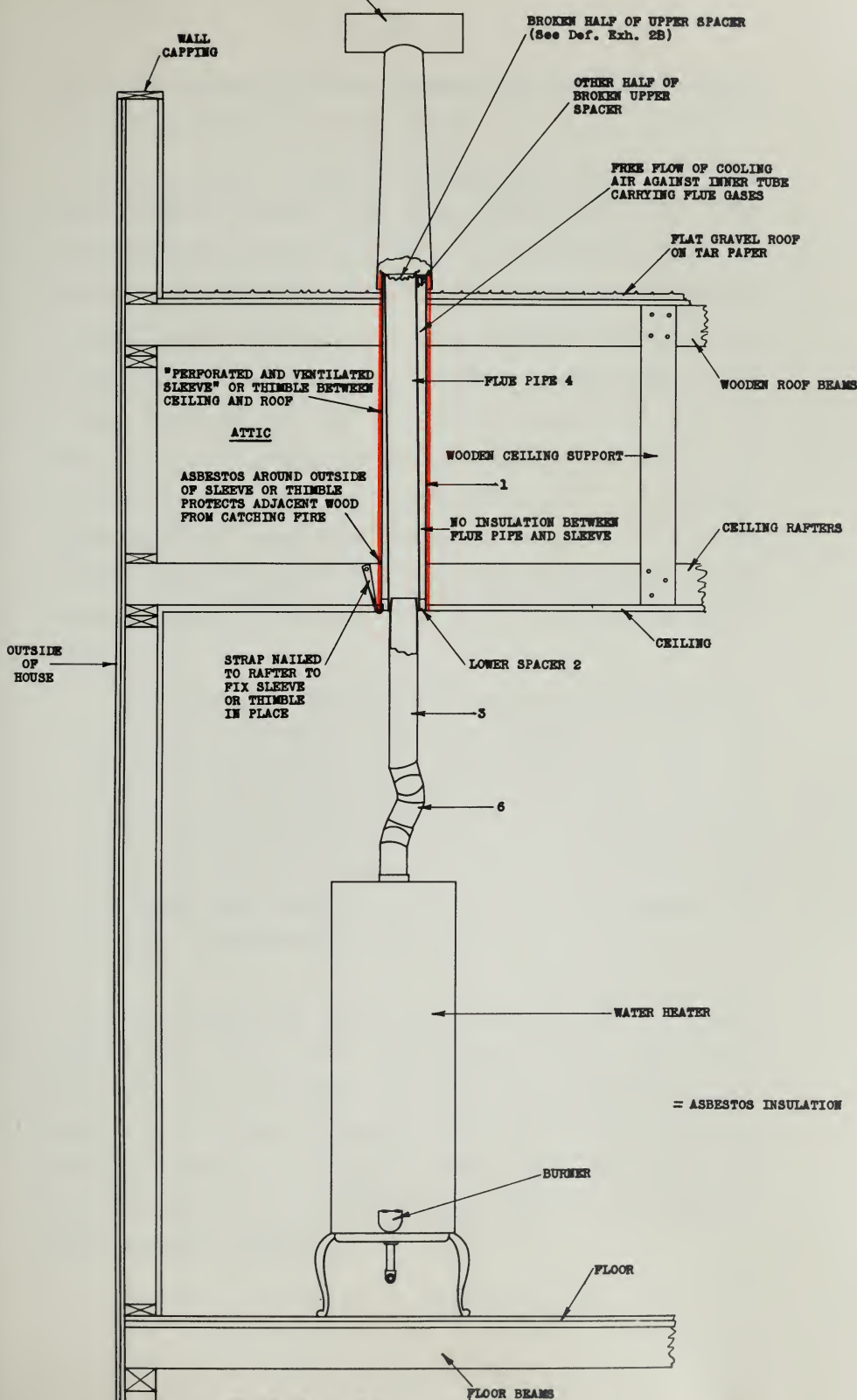
*The Abandoned "Los Angeles" Flue* (Def. Ex. 1, I. 86).

Depositions were taken to establish three installations of this obsolete, outlawed Los Angeles flue. Appellant refers now (p. 33) only to the Baker installation. The depositions were intended to show what had been the practice in Los Angeles for some twenty years before that city, about 10 years ago, banned any further like installations (II. 372). *Today these "Los Angeles" flue installations* are outlawed, yet the flue pipe sold by appellant is lawful and sold with great success. We cannot escape the conclusion that the old Los Angeles structure is not like the patent in suit.

We have prepared a diagrammatic showing of the Baker installation, which was simply a one-tube flue pipe 4, passed through "a perforated and ventilated sleeve or collar" 1 (L. A. ordinance 1924, Def. Ex. 9, (III. 799), no longer in force). The "perforated and ventilated sleeve or collar", called for by the ordinance, extended only between the ceiling and the roof and had an asbestos covering on the outside. It was fixed in place by straps nailed to a rafter in the attic.

*There was no insulation placed around the portion of the flue pipe where it passed through the thimble, or at any other point.* On the contrary, all the testimony establishes that there was to be a *free flow of cooling air against the flue pipe* throughout its length, as well as through or close to combustible materials. The Los Angeles ordinance then called for ventilation between flue and thimble,—the very antithesis of Stadtfeld's teaching. There was no attempt whatever to insulate the flue pipe as Stadtfeld







did, either where it passed through the thimble or where it was exposed in the room below.

The net result of such a construction was a flue pipe which could not attain high temperatures (II. 573). This meant that the flue pipe, lacking any insulation whatever applied to the flue pipe itself, could not operate efficiently.

When Baker removed the fixed thimble 1 and section of flue pipe 4, the latter was "heavily coated with soot" on the inside (L. A. Tr. 91), which meant that the flue temperatures had been too low to establish for the burner the proper conditions for combustion, and a dangerous "floating flame" had been the result (II. 573). This soot deposit shows "it could not have been functioning in the proper manner or we would not have that carbon deposit." (II. 573).

"It indicates that the combustion of the burner of whatever appliance this was hooked to was not functioning properly; in other words, there was not a proper draft to insure proper combustion; the only time that you *should or will get a sooty condition like this* from an appliance burning gas is *when that floating flame prevails where you are not getting the proper combustion*" (II. 573).

The uncontradicted testimony establishes that the Los Angeles flue did not give a satisfactory draft; that it was hazardous and dangerous causing carbon monoxide to be present in excessive quantities; and that if the joints are not tight there is no place for these gases to go but out into the room (II. 513). No wonder then that the authorities banned it from use.

There is no suggestion in the Baker installation of any construction like the patent in suit. In Baker there was no concept of having a plurality of sections joined together to form a twin-tube, insulated flue pipe extending from appliance to roof. *There was no concept of insulating the single flue pipe.* The operating theory of this Los Angeles flue is the very antithesis of Stadtfeld's concept. Stadtfeld conceived a flue pipe construction that keeps the flue pipe throughout its length *as hot as the gases passing through it can possibly heat it.* The Los Angeles flue cools the flue pipe to as low a temperature as the free flow of air against it can effect. The Los Angeles device did not embody any of the features which make the Stadtfeld invention a success.

*“A device which does not operate on the same principle cannot be an anticipation.”*

*Los Alamitos Sugar Co. v. Carroll*, 173 Fed. 280, 284 (C. C. A. 9).

This obsolete Los Angeles flue was a failure and obviously is not the same as the lawful successful Stadtfeld flue, or appellant would still be making and selling it, as it did for many years and in great quantities before it became outlawed.

Appellant's reference (p. 31) to its bulletin (III. 903) suggesting joints to shed moisture only goes to emphasize the novelty of Stadtfeld's invention. Appellant had made the Los Angeles flue for years, it knew when it became outlawed and that for years after there was a feverish search for a new metal flue pipe that would take its place. It knew about male and female joints, yet it never

occurred to appellant to put all the parts together the way Stadtfeld did so successfully.

“Prior patents, none of which solved the problem, can have no effect in anticipating, qualifying, or defeating the claims for patent protection of those whose subsequent effort produced success. Consolidated Window Glass Co. v. Window Glass Machine Co. (C.C.A.) 261 F. 362.”

*Babcock & Wilcox Co. v. Springfield Boiler Co.*, 16 F. (2d) 964, 969 (C. C. A. 2).

This completes a discussion of the only flue pipe art cited by appellant. The remaining art is non-analogous if for no other reason than the fact that it is not flue pipe and *cannot be used as flue pipe without complete reconstruction to make it over from what it is*. But this would not be proper, as this Court has repeatedly held patents “cannot be reconstructed in the light of the invention in suit, and then used as a part of the prior art.” *J. A. Mohr & Son v. Alliance*, 14 F. (2d) 799, 800 (C. C. A. 9). See also *Stebler v. Riverside*, 205 F. 735, 738 (C. C. A. 9). And yet that is what appellant attempts. This non-analogous paper art is not relevant and is discussed in the appendix under the respective art classifications to which each item relates. The O’Toole and Meade patents with which appellants take so many liberties (pp. 28, 29), are admittedly not flue pipes nor adaptable for flue pipe use. Their lack of pertinence is shown completely at pp. iii, v of the appendix.

## THE NON-ANALOGOUS PAPER ART.

Two Patents Show Steam Pipe Covering Materials (See page i of appendix).

Hammill No. 311,750 (Def. Ex. 4-A, III. 711)

Aldrich No. 340,691 (Def. Ex. 4-B, III. 714)

One Patent Shows a Thimble (See page iii of appendix).

Meade No. 1,428,294 (Def. Ex. 4-F, III. 730)

One Patent Shows an Underground Conduit (See page iv of appendix).

Harvey No. 534,473 (Def. Ex. 4-D, III. 722)

One Patent Shows a Water Pipe (See page v of appendix).

Welch No. 1,927,105 (Def. Ex. 4-G, III. 735)

Four Patents Show Hot Air Pipe (See page v of appendix).

O'Toole No. 878,014 (Def. Ex. 4-E, III. 726)

Bradbeer No. 390,438 (Def. Ex. 6-A, III. 780)

Line No. 690,744 (Def. Ex. 6-C, III. 787)

Line No. 696,059 (Def. Ex. 6-D, III. 790).

We respectfully submit that in no respect has appellant shaken the manifest correctness of the District Court's validity and invention findings Nos. 11, 12, 13, 14, 15 and 16. (I. 51) The prior art references cover the efforts of the skilled men in this art for a period of forty years preceding Stadtfeld's discovery. The failure of them all to make the invention demonstrates that what Stadtfeld did was in fact obvious to no one until he got the happy thought of his new combination. What he did went counter to the prior teachings in the flue pipe art. Appellant's effort to spell the Stadtfeld invention out of obsolete, prior art structures by a process of interpretation and

expansion defeats itself. Its own conduct in making a "chinese copy" of the Stadtfeld pipe instead of the prior art defeats it (See Supreme Court Tire case supra p. 7.) Its advertising (supra p. 47) heralding the novelty of the very features which distinguish Stadtfeld from the prior art defeats it. All appellant has done is what this Court refused to sanction in *Stebler v. Riverside*, 205 F. 735, 738:

"True, we may pick out one similarity in one of these devices, and one in another, and still one in another, and by combining them all, anticipate *the inventive idea* expressed in the Strain patent, but *the combination constituting the invention is not found in any one of them.* \* \* \* It is accordingly held that the defense of anticipation is not sustained."

*Appellant's exact copying of the Stadtfeld structure and its inability to adopt any of the prior art devices in lieu of the invention in suit*, makes applicable as if it were written by the Supreme Court for this very case, the language quoted above at page 7. To paraphrase what the Court said in that Tire case (p. 441) and apply the language to this case:

"The prior art was open to appellant. That 'art was crowded', it says, 'with numerous prototypes and predecessors' of the Stadtfeld flue pipe, and they, it is insisted, possessed all of the qualities which are attributed to the Stadtfeld pipe. And yet the appellant uses the Stadtfeld pipe. It gives the tribute of its praise to the prior art; it gives the Stadtfeld pipe the tribute of its imitation. And yet the narrowness of the claims seemed to make legal evasion easy. Why, then, was there not evasion by a variation of the details of the patented arrangement? Business

interests urged to it as much as to infringement. We can find no answer except that given by appellee: 'The patented organization must be one that is essential. *Its use in the precise form described and shown in the patent must be inevitably necessary.*' "

Stadtfeld's combination is of a type clearly recognized in law as patentable. Compare the gas clothes dryer held patentable in *Judelson v. Hill*, 18 F. (2d) 594, affirmed 22 F. (2d) 262 (C. C. A. 2), which case on its facts parallels so closely the present one. There had long been "a real problem in the art. Judelson made a number of attempts. Finally he discovered the combination. \* \* \* This idea and arrangement of a box with baffles was new in the art. *It was a scientific arrangement of old elements, which produced a new result.* \* \* \* it was the result of Judelson's thought and experiment. \* \* \* The Judelson heater also met with immediate commercial success." There, as here, defendant persisted in making the patented structure instead of the prior art. "It was the adaptation of various elements, old in themselves, but in a new combination, in which these old elements function differently and produce a new result. \* \* \* This was new and it worked. \* \* \* The demand and the money reward for a discovery meeting the demand had been present for some time. Just why, if this was merely a mechanical substitution, available certainly to defendant as well as to plaintiff, defendant should wait until what has been said to be the new idea of Judelson came upon the market, is not plain. \* \* \* Where a patent has been substantially copied, the Court should not be too astute to upset that patent. \* \* \*"



Many similar decisions of this Court can be found which held invention in a combination of old parts which in their new combination produce a new result and function differently (*Stebler v. Riverside*, 205 Fed. 735, 738 (C. C. A. 9); *Reinharts, Inc. v. Caterpillar Tractor Co.*, 85 F. (2d) 628, 635 (C. C. A. 9); *Mohr v. Alliance*, 14 Fed. (2d) 799 (C. C. 9); *Walker on Patents* (Del. 6 Ed.) p. 147. These are very different from the *Ray v. Bunting* case relied on by appellant, because there there was no new result or function from the combination.

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9. THE STADTFELD ORIGINAL CLAIMS 1, 2 AND 3 AND CANCELLED CLAIMS 3, 4, 5 AND 8 ARE NOT PRIOR ART AND CANNOT BE USED TO ANTICIPATE THE PATENT.

Lacking any relevant prior art to support its appropriation of the invention, appellant in desperation attempts to manufacture some prior art of its own. However, there is no justification in law or fact for this attempt in appellant's brief (pp. 26-34) to assert that the disclaimer claims are invalid by saying the Stadtfeld disclaimer admitted the original claims 1, 2 and 3 were invalid; and by saying the cancellation of claims 3, 4, 5 and 8 admitted the disclaimer details were not new. Neither statement or assumption by appellant is true.

Just as appellant's argument (pp. 28-33) attempts to piece together the prior art, taking a little here and a little there, etc., to make up the Stadtfeld pipe, so, in this erroneous argument about the effect of the disclaimer and of cancelling claims, it attempts to piece together

some law, made on the spot, and then to apply this to assumed facts.

An examination of the file wrapper (III. 694) shows that claims 1, 2 and 3 as originally granted were for the three elements,—the inner tube, the outer tube, the insulation, and the functional limitation of slidability. On the other hand it shows (III. 694, 698) that cancelled claims 3, 4, 5 and 8 never included the functional limitation of slidability and claim 8 in addition never included the third element, insulation. *Therefore, the allowed claims were never co-extensive with the cancelled claims.* By cancelling claims 3, 4, 5 and 8 Stadtfeld did not admit that the structure of those claims was old, but only that he did not choose to assert further his claim to them. Here is the first assumption by appellant's argument (pp. 34, 30), which is not supported by the law about the effect of cancelling claims:

“It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, *he dedicates it to the public.*”

*Miller v. Bridgeport Brass Case*, 104 U. S. 350, 352.

In other words, *by cancelling a claim the patentee does not automatically manufacture prior art against the claims he does accept* (compare *Johnson v. Philad Co.*, 96 F. (2) 442, 444, 2nd column (C. C. A. 9)). He does estop himself from ever contending that the claims he accepts are to be construed as broadly as those that were given up, and appellant is free to make the two-element construction of claim 8 because Stadtfeld dedicated that to the public. That

question is not involved here and there is no rule of law to support appellant's unjustified attempt to confuse the rule on estoppel just mentioned, with some hypothetical rule that a cancelled claim becomes prior art. It definitely does not, as Judge Learned Hand held in *United Chromium v. International*, 60 F. (2d) 913, 915 (C. C. A. 2):

“It is never for instance a good defense to a claim that it might have been broader; *the patentee need not at his peril claim all that he might; he does not concede that each element is necessary to avoid anticipation.* He may prove an invention broader than he claimed; the unnecessary elements introduced need not be themselves an invention. *Else it would be possible to invalidate any claim by showing that the patentee had yielded too much to the Examiner.*”

The other erroneous, unsupported assumption (pp. 28, 30 and 34) which appellant couples with the one just discussed is the same fundamental error which appears unsupported throughout appellant's brief (pp. 3, 6, 8, 10, 27, 30, 34 and 36) to the effect that filing a disclaimer is an admission that the claims are invalid, therefore the original claims can be used as prior art. We have already cited two authorities (p. 41, *supra*) which show the correct rule of law is that filing a disclaimer of the Stadtfeld type, relinquishing any supposed equivalents, is very definitely not an admission of invalidity. An authority in addition to those already cited is *Manhattan v. Helios*, 135 F. 785, where the Court ruled that the *disclaimed matter could not be used as prior art.* This clearly answers the unsupported contention of appellant:

“There is no admission, however, in this that the subject of the disclaimer appears in the prior art,

which may not by any means be the case, *nor is there any justification for so construing it.* It merely takes out of the patent the excided matter, leaving it as though it had never been there. This does not, of course, prevent that which is disclaimed from being identified with anything to be found in the prior art—such as the Spencer lamp, for instance, in the case in hand—with whatever argument may be legitimately drawn therefrom. But *there is no sanction for using the disclaimer as evidence that there is any such device in fact, which is the effect sought to be given it here, as to which it does not undertake to speak.*”

And as Judge Learned Hand said on this point in the *Chromium* case, 60 F. (2d) 913:

“There is no reason to impute to his caution a declaration about what the prior art actually contains.”

Also see *Bay State v. Klein*, 20 F. (2d) 915 where the Court said:

“Defendants contend that the filing of the disclaimer constitutes an admission that the patent in suit, without disclaimer, would have been invalid. This contention, in my opinion, is erroneous (citing cases). This was not a disclaimer, where a claim or claims had been held invalid by a court.”

And *National Fruit v. Musselman*, 8 Fed. Supp. 994 (Pa.):

“The filing of a disclaimer is not an admission that the subject matter of the disclaimer appears in the prior art, and the patent therefore is not on that account invalid.”

We respectfully submit that such technical groundless arguments only serve to emphasize the lack of merit in appellant's whole case.

Appellant's citation (p. 27) from the *Altoona* case is not in point because there the court was discussing the effect of a disclaimer *after* it had held the disclaimer defective, and what it said was that the original claim could not be revived when the disclaimer failed.

Appellant's contention (p. 26, line 24) that the rejected subject matter of claims 3, 4, 5 and 8 was incorporated in the claims by the disclaimer is not justified nor correct, if by that appellant means that the disclaimer made the claims co-extensive with any of these cancelled claims. The authorities on estoppel, above (p. 64) show that that is the only situation that would be fatal. We have already seen (p. 64, supra) that it did not make the claims co-extensive, and so we don't have here that situation. Appellant cites no authority which denies a patentee the right given by the disclaimer statute of limiting general elements to a specific form as described in the specification (see Supreme Court approval in *Altoona* case note supra, p. 26). In fact this is what was done in each of the court approved cases of limiting disclaimers (cited at pp. 32, 33, 36, supra) and it is what Stadtfeld did here.

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**10. THE CLAIMS ARE FOR A PATENTABLE COMBINATION AND NOT AN AGGREGATION, AS THE TRIAL COURT CORRECTLY FOUND.**

This was the trial court's finding No. 22 and appellant (p. 35) introduces no new consideration which would

show that there is any error in the finding. There is no such rule as appellant seeks to imply. (See *Walker on Patents* (Deller Ed.) p. 216). Mr. Connor, appellant's former patent counsel, had no difficulty in seeing a patentable combination in the new arrangement of twin pipes with independent joints and the intervening insulation to keep the pipes spaced apart and the inner one cooled. (III. 884). We know of no better discussion on the question of aggregation than in *Sachs v. Hartford*, 47 F. (2d) 743, 748 (C. C. A. 2) which fully sustains the District Court's finding No. 22 (I. 54).

“We have not dealt with the defendant's argument that the first patent is for an ‘aggregation’. Frankly, we are unable to attach a definite meaning to that word. The notion that the parts of an invention must co-operate is certainly very persisting in the patent law, and it must correspond to some underlying idea. So far as it means that the whole complex claimed must be a unit in use, each part of which shall be necessary to the common result, we can understand it. So far as it rests upon an implied reference to mechanics, that is, that each part must give or take a strain, *it seems to us a false lead*. The test is more practical than that because inventions are to answer human needs, and the elements may be mechanically inert. *The cooperation of the means necessary to create an invention is to be measured by the purpose to be fulfilled, not by the interaction of the parts*. Each factor must indeed be a condition to that result, but the whole may be a mere assemblage; *the cooperation between them all may be no more than their necessary presence in a unit which shall answer a single purpose*. Therefore, we can find little advantage in a discussion of what is or what is not

an 'aggregation'. In patents, as in other branches of the law, the question is of the interests involved; inventions depend upon whether more was required to fill the need than the routine ingenuity of the ordinary craftsman. Such a standard is no more of a will-o'-the-wisp than others which the law adopts, reasonable care, reasonable notice and the like; the effort is to fix that standard by recourse to average propensities, dispositions and capacities. Any attempt to define it in general terms has always proved illusory; it is best to abandon it."

And so we come to the end of examining the technical attacks appellant makes on the trial court's validity and invention findings. The record and appellant's own conduct show that Stadtfeld put together something that it can't get along without. (See *Mohr vs. Alliance*, 14 F.(2) 799, 800 (C.C.A. 9) top of 2nd column). Nowhere does the prior art contain that something. Clearly, Stadtfeld's mental concept of a new kind of twin-walled flue pipe comprising the three elements, inner and outer tube and insulation in between, with slidability, was of a patentable character and entirely new in the art. Appellant's brief scarcely denies this. The limiting disclaimer was prepared in exact conformity with those approved by the Supreme Court and other federal courts. Certainly, there is no showing in appellant's brief that would warrant this Court in disturbing the findings of the Court below. Appellant's whole conduct toward the invention places it in an unenviable position: first in failing to carry out its agreement with Stadtfeld, and then when the invention got into the strong hands of appellee, its competitor, of trying to buy the invention, and then, when refused, of stubbornly

insisting on appropriating it on the possible chance of an inadvertent decision. Lest appellant itself focus attention on this additional unfavorable aspect of the case, it abandoned its alleged shopright or license defense and many other contentions advanced in the Court below.

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### CONCLUSION

This case presents an important invention for adjudication by this Court. The decree below is fully supported by the complete findings of the trial judge. These dispose of every contention advanced by appellant to this Court. Appellant can show no error in these findings, and there is none. We submit that the decree below should be affirmed. The result will be to reward properly the making of a truly meritorious invention in accord with the purpose of the patent laws.

“If there be one central controlling purpose deducible from all these decisions, and many more that might be quoted, it is the steadfast determination of the court to protect and reward the man who has done something which has actually advanced the condition of mankind, something by which the work of the world is done better and more expeditiously than it was before.”

*Hallock v. Davison*, 107 F. 482, 486.

Respectfully submitted,

A. DONHAM OWEN,

*Attorney for Appellee.*







## Appendix.

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### NON-ANALOGOUS PAPER PRIOR ART.

The flue pipe prior art is discussed at page .... supra. The following discussion relates to the non-analogous art which appellant has gathered together in desperation over the few patents it found in the flue pipe art.

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#### Two Patents Show Steam Pipe Covering Materials

Hammill No. 311,750 (Def. Ex. 4-A, III. 711)

Aldrich No. 340,691 (Def. Ex. 4-B, III. 714)

Covering for steam pipes as shown by these patents dates at least from 1885. As far back as any of us can remember we can recall seeing steam pipes wrapped with an asbestos coating and usually held around the pipe by metal straps. This can be seen in the basement of any building heated by steam. The problem in steam pipe covering is very different from a flue pipe and is to provide an insulating structure which can be placed around the steam pipe after the pipe is joined together and each joint is tested for leakage by a steam fitter.

Two forms of covering have been in general use, and are typified in the above patents. One form is shown in Fig. 2 of Hammill (Def. Ex. 4-A) where the insulating material is wrapped, layer on layer, around the pipe until the desired number of wrappings is obtained and then a covering of asbestos paper A' is secured around the outside. The other form is shown in Fig. 3 of this same

patent and comprises making up the insulating covering around a mandrel about the size of the steam pipe A and when completed it is slit longitudinally so that it can be spread open when installing it around the steam pipe, as it cannot be slid over the end.

Steam pipe coverings are not an analogous art to flue pipes. Operatively they have nothing in common. A flue pipe has the gases of combustion in contact with it. A steam pipe covering has no gases to convey. A flue pipe accumulates on its inner surface condensed moisture from these hot gases. A steam pipe covering does not have a moisture problem on the inside. A flue pipe like appellee's and appellant's must have two independent leak-proof jointed concentric strings of tubing to entrap the gases on the inside and protect the intervening asbestos from moisture coming from either the inside or outside. A steam pipe cover need do only one thing, namely, provide a layer of insulation around the steam pipe.

There is no problem, when covering a steam pipe, of installing the steam pipe and the covering, section by section, while one is within the other, therefore, relative slidability has never been a factor.

*It is perfectly obvious that steam pipe covering would not function as a flue pipe. Appellant offered no proof to show that it would and defendant's own letter exhibits chronicalling some of Stadtfeld's early experiments at Waylands show that at one time he tried to make flue pipe substantially like steam pipe covering and it was a failure.*

A modified form of steam pipe covering is shown in *Aldrich*, 340,691 (Def. Ex. 4-B), having a felt packing inside two sheet metal plates I and B.

*We call the Court's attention to the bolts L at each end of the drawing of Fig. 1, which extend between the two metal members I and B and positively prevent any slidability* (patent p. 1, line 70).

There is no need for slidability in *Aldrich*, for his steam pipe covering is made up in the flat at which time bolts L are put in. They hold the several layers against slidability. These flat assemblies are laid against the steam pipe and then bent around it and locked by the bolt M in band K (patent p. 1, lines 72 to 82).

*The tubes thus formed are not seamed and would not be gas tight, therefore, if any attempt were made to use the assembly as a flue the gas would leak out.* The joints are both male on one end and both female on the other end. This would cause further leaks. *This "steam pipe or boiler covering" would be absolutely useless as a flue pipe.*

Not one of these patents on steam pipe covers meets the claims in suit. The Court can very quickly satisfy itself on this by turning to the claims and disclaimer.

#### One Patent Shows a Thimble

Meade, No. 1,428,294 (Def. Ex. 4-F, III. 730)

Meade shows a stove pipe thimble and is the next of the patents to be considered. Appellant's comments on this patent (pp. 29, 31) are of no value whatsoever.

A thimble is a device used to space a flue pipe or stove pipe away from combustible portions of a dwelling structure. *It is not a flue pipe as it does not convey any gases of combustion.*

The stove pipe is shown in dotted lines in Fig. 1 of the patent. Appellee made up two scale models of the device (Pl. Ex. 22-A, 22-B) to show that they could not be used to convey gases. *One object in a thimble is to allow as much cooling as possible of the inner pipe, hence the air space between the pairs of cylinders 13 and 12 (see Fig. 2). This is opposite to the purpose of the patent in suit which fills the space between the tubes with insulation to prevent cooling of the inner tube.*

Meade has no male and female ends on the tubes arranged to shed moisture condensing on the inside or falling on the outside. *Meade lacks any way of connecting together a series of inner tubes and of outer tubes.*

#### One Patent Shows an Underground Conduit

Harvey No. 534,473 (Def. Ex. 4-D, III. 722)

Just what relationship an underground conduit has to a flue pipe appellant nowhere explains. Appellant cites no authorities to show it is an analogous art. The problems certainly are not those in the flue pipe art.

We submit that one glance at the patent is enough to show its complete lack of disclosure and the utterly frivolous contention of appellant.

*Appellee's witness testified without contradiction that Harvey was not suitable as a flue pipe (II. 566) and that it would be impossible to erect. Another drawback is that*

the terra cotta pipe shown, if used for a gas flue, would not be efficient and would cause "condensing of the gases quicker than anything else" (II. 568).

*Appellant furthermore made no effort to establish that it would operate like the patent in suit and the authorities (Los Alamitos v. Carroll, 173 Fed. 280, 284, C. C. A. 9) show such identity must be established.*

#### **One Patent Shows a Waterpipe**

Welch No. 1,927,105 (Def. Ex. 4-G, III. 735)

This patent for a water-pipe cannot be said to be in the flue pipe art. Aside from this there is a complete failure of disclosure of a structure which could serve as a flue pipe. Appellant made no effort to show it could be so used.

Appellant, apparently embarrassed by the remoteness of this patent, seeks to dismiss it without particular comment beyond the conclusion that it is "anticipatory" (p. 28).

#### **Four Patents Show Hot Air Pipe**

O'Toole No. 878,014 (Def. Ex. 4-E, III. 726)

Bradbeer No. 390,438 (Def. Ex. 6-A, III. 780)

Line No. 690,744 (Def. Ex. 6-C, III. 787)

Line No. 696,059 (Def. Ex. 6-D, III. 790)

*The object in hot air pipe is to convey hot dry pure air from a furnace in the cellar directly into the rooms to be heated. Installations are inside of dwelling walls shielded from outside moisture. Thus, there is no moisture problem, either inside or outside the pipe and it makes no difference*

*what kind of connections are made between the sections of pipe. Nor is it essential that these connections be gas tight since the air is pure and not poisonous products of combustion. Lacking any of the problems encountered in the flue pipe, it is clear why neither O'Toole, Bradbeer, nor Line discloses any concept of a flue pipe like the one in suit. They are in a different art.*

A year before Stadtfeld applied for his patent, appellant's then patent attorney, Connor, distinguished the Stadtfeld invention from O'Toole and Line and said they should not stand in the way of securing a patent for Stadtfeld (III. 884).

To adapt or reconstruct the O'Toole device to the purposes of its argument, appellant *has changed* the inner tube 2 to a seamed tube and *omitted the rivets 4*. Appellant *then proposes* to have the sections supported one on top of the other, whereas the patent shows them spaced apart at each joint. Even with all of these changes O'Toole does not have even a superficial resemblance to the device in suit. Furthermore, *none of these changes is described or suggested in the O'Toole patent.*

No one thought of making these changes before appellant's counsel made them.

*Appellee's and Appellant's witnesses agree that as a flue pipe O'Toole would disqualify because moisture entering at the open joints "would soon destroy its insulating value" (II. 168, 372, 563). Appellant made no effort to overcome appellee's proof that the O'Toole patent was impractical for a flue pipe. If appellant asserts it is the*

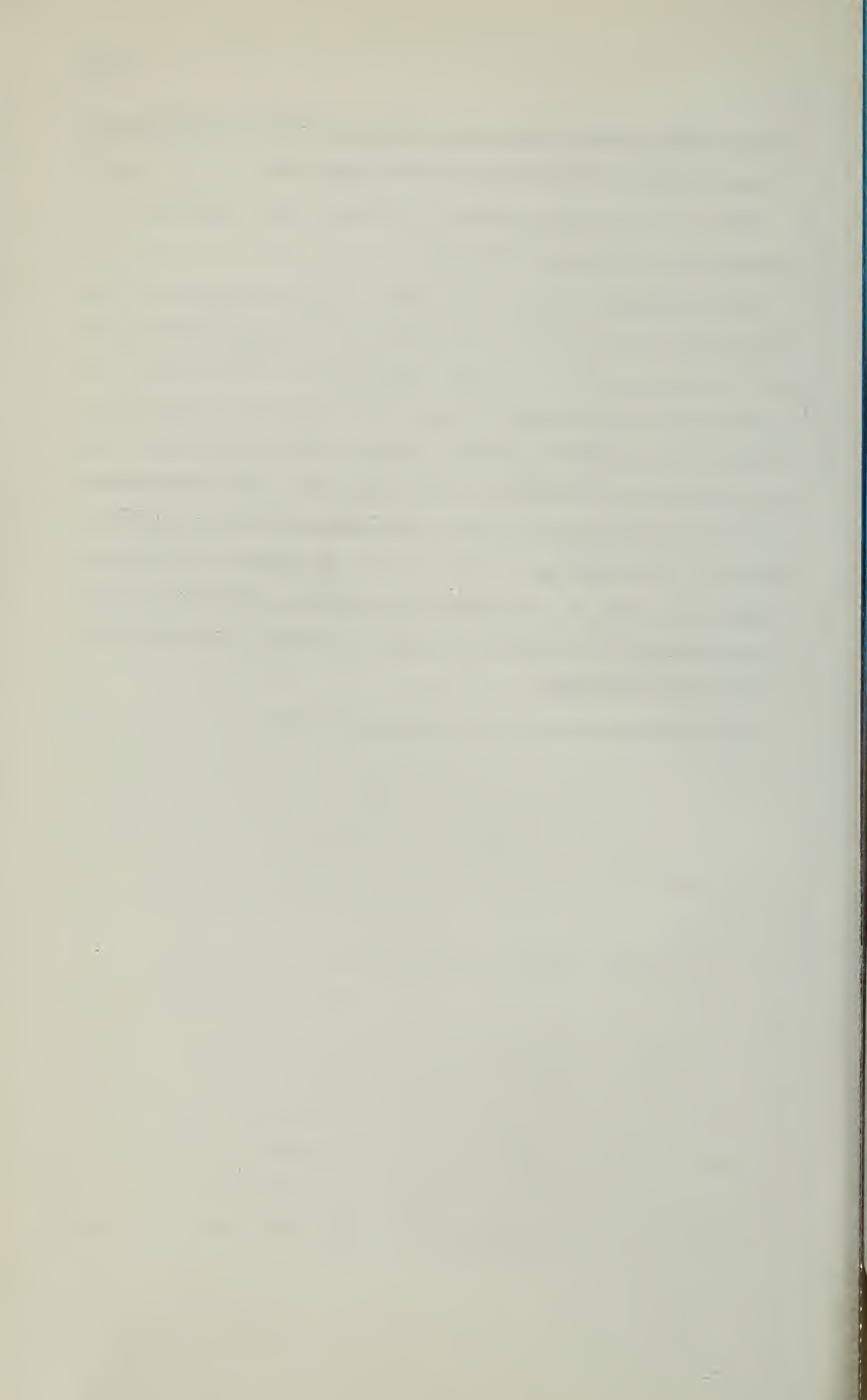


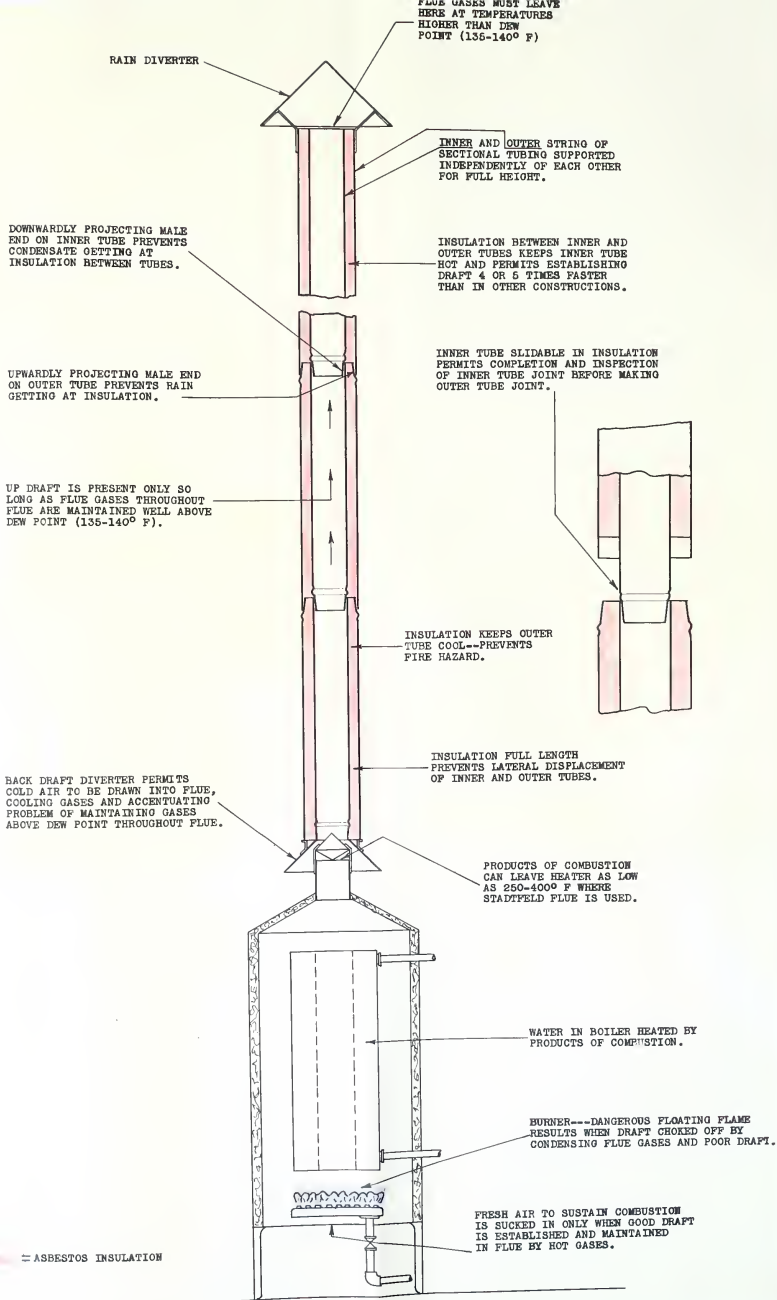
same thing, which inspection alone discloses is not true, it was appellant's burden to show it by test.

Reliance on such patents as these only discloses the desperation of appellant's case.

*The Bradbeer patent* was a file wrapper reference and appellant *proposes to reconstruct* it by taking it all apart and reversing the inner and outer pipes so as to get the male and female ends of the tubes adjacent. *Appellant overlooks several significant things.* First, none of this reconstruction is suggested by Bradbeer, who invented a hot air pipe where moisture and joints are not a problem. Second, the coupling members a<sup>3</sup> of Bradbeer won't function with such a rearrangement. Third, Bradbeer lacks the element of insulation between the tubes. Fourth, Bradbeer lacks slidability.

*The Line patents* are even more remote.





TYPICAL STADTFELD INSTALLATION

